

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,372,884 (COLORWORX)
Registered January 22, 2008

78 698, 743

Opposition No. 91203884

Ennis Inc.

v.

Joel L. Beling d/b/a Supa Characters Pty Ltd

**SECOND AMENDED
PETITION TO CANCEL**

Cancellation No. 92055374

Joel L. Beling d/b/a Supa Characters Pty Ltd

v.

Ennis, Inc.

SECOND AMENDED PETITION TO CANCEL¹

1. Petitioner, JOEL L. BELING d/b/a Supa Characters Pty Ltd, Director of Supa Characters Pty Ltd, Barrister and Solicitor of the Supreme Court of Victoria, Doctor of Philosophy, refers to the Trademark Trial and Appeal Board's ("TTAB" or "Board") ruling on this matter dated July 13, 2012 and submits this Amended Petition to Cancel.

¹ Petitioner wishes to thank the Trademark Trial and Appeal Board for its specific guidance in pleading this Petition; of course, Petitioner accepts full responsibility for any and all errors contained herein. Petitioner notes the Board's helpful comments in respect of the benefits of legal representation and respectfully advises the Board that he cannot afford to pay for legal representation.

2. Petitioner believes that he is and/or will be damaged by U.S. Registration No. 3,372,884 (the “Registration”), registered in the name of Ennis, Inc. (hereinafter “Registrant”), a Texas corporation, having a place of business at 2441 Presidential Parkway, Midlothian, TX 76065, United States, and hereby petition to cancel said registration.
3. Petitioner filed his original Petition to Cancel (“original Petition”) with the Board on or about March 23, 2012, by filing same electronically through the Electronic System for Trademark Trials and Appeals (“ESTTA”).
4. Petitioner notes Registrant filed a “Motion For More Definite Statement Or, In The Alternative, Motion To Strike” in response to Petitioner’s original Petition. In that Motion, Registrant alleged that “[t]he Petition is so vague that Registrant cannot file a meaningful responsive pleading” (p.1). This Motion required Board intervention and a ruling. In order to avoid a recurrence of this situation, Petitioner has attempted to particularize his allegations more so as to avoid allegations of vagueness and/or ambiguity and so that Registrant can file a meaningful responsive pleading.

STANDING

5. With respect to standing, petitioner believes and alleges he has a real interest and direct and personal stake in the cancellation of Registrant’s Registration because he intends and desires, either by himself or through a third-party licensee, to offer for sale printing services - more specifically, those goods particularized in class 16 of Application No. 85,324,443 (COLOR WARS) – using the words “color works” and because “color works” is a generic and descriptive term of the goods offered for sale by all sellers of

printing services, printed goods and stationery, and more generally, any work produced in any industry involving the use of color. Accordingly, Petitioner believes he has a reasonable basis to believe he will be damaged by Registrant's Registration because "COLORWORX" is simply an insignificant misspelling and abbreviated composite mark of "color works" or, in expanded form, "works of color," terms which are necessary in the trade of goods and services involving works of color. Petitioner believes Registrant has no right to claim a continuing legal and trade monopoly over a word which is generic, descriptive and necessary for use generally by all sellers of goods involving works of color and in particular, by all sellers of printing services. Petitioner also believes, based on a good deal of direct and indirect circumstantial evidence (particularized herein), that Registrant has committed fraud on the USPTO.

6. In addition, Petitioner intends to trade in commerce printed goods and printed materials in the United States under the following trademarks, which are all the subject of live trademark applications before the USPTO: "THE BIG FIVE" (85320662), "JOINT SUPER CHIEFS: ARMO, NAVO, AIRFO, MARINO" (85324466), "EMPIRE OF ELEMENTS" (85325778), "GREEN GANG" (85325726), "SUPER DOGS" (85325751), "HEAVENLY BODIES, STAR SIGN SUPERSTARS, ZONE OF THE ZODIAC" (85347523), "WEATHER GODS AND GODDESSES" (85356159), "MUSIC MEN" (85324595), "ENERGY MEN" (85325449), "BATTLE OF THE PLANETS" (85325826), "WARRIORS OF THE WORLD" (85976401), and "ULTIMATE SPORTING HEROES CHAMPIONSHIP" (85437351). Petitioner believes that Registrant has frivolously and maliciously opposed bona fide applicants in their applications to register marks with the USPTO relating not just to printed materials and

printing services, but also to other goods and services completely unrelated to Registrant's core areas of business. For example, Registrant opposed Petitioner in his application to register his COLOR WARS mark with respect to goods and services in international class 41, and then, after a number of months of intensive Discovery, advised Petitioner in a letter dated June 21, 2012, that it no longer opposed Petitioner in respect of his applied-for class 41 goods and services. Registrant's actions have caused Petitioner massive stress, financial loss, and prevented him from pursuing both his usual work as a criminal lawyer in Australia and his superhero character licensing business under Supa Characters Pty Ltd.

7. A final, compelling reason Petitioner has standing to file this Petition is Registrant's own allegations in Opposition No. 91203884. In its Notice of Opposition dated February 15, 2012, Registrant made the following allegations regarding the relationship between Petitioner's COLOR WARS mark and Registrant's COLORWORX registration and design:

5. Applicant's Mark so resembles Opposer's Mark that has been and is currently used, as to be likely to cause confusion, or cause mistake, or to deceive, in violation of Section 2(d) of The Trademark Act, 15 U.S.C. §1052(d), when used on or in connection with Applicant's Goods.

6. Under the circumstances, registration of Applicant's Mark will injure Opposer by causing the trade and/or purchasing public to be confused and/or deceived into believing that Applicant's Goods are those of Opposer or are sponsored by Opposer, to Opposer's damage and detriment, and will place a cloud over Opposer's title to its COLORWORX Mark in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

7. Opposer's COLORWORX Mark was well established long before the filing date of Applicant's subject application, and at the time that Applicant filed the subject Application. Registration of Applicant's Mark would diminish and dilute the distinctive quality of Opposer's rights in its COLORWORX Mark in violation of 15 U.S.C. §1125(c). Moreover, registration of Applicant's Mark would diminish the advertising value of

Opposer's Mark, and such registration would, in the event of any quality problems involving the goods offered by Applicant, tarnish the distinctiveness of Opposer's Mark.

8. Applicant's Mark is the same as, or substantially the same as, Opposer's Mark, including in visual appearance and in pronunciation.

9. Applicant's Mark is likely to and/or has diluted and lessened the capacity of Opposer's Mark to identify and distinguish Opposer's Goods.

10. Applicant's Mark so resembles Opposer's continuously used and well-known Mark as to be likely, when used in connection with the goods as set forth in Applicant's application, to lessen the capacity of Opposer's Mark to identify and distinguish Opposer's Goods.

11. The subject application should be refused because Opposer's rights of continuing its present use of its Mark in commerce are, or would be, threatened by Applicant's registration of Applicant's Mark for Applicant's Goods, and because Opposer's business would otherwise be damaged by Applicant's registration of Applicant's Mark for Applicant's Goods.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's COLOR WARS mark and prays that the Trademark Trial and Appeal Board sustain this opposition and refuse to register Application Serial No. 85/324,443 with prejudice.

8. In short, if Registrant argues that Petitioner has no standing to file this Petition, then it is respectfully submitted that Registrant's attorneys should be subjected to condign disciplinary action for filing a Notice of Opposition and making allegations against Petitioner in egregiously bad faith.

The grounds for cancellation are as follows:

COUNT I

REGISTRANT'S COLORWORX REGISTRATION SHOULD BE CANCELLED

AS THE TERM "COLORWORX" IS MERELY GENERIC

15 U.S.C. § 1064(3)

9. Petitioner incorporates all previous paragraphs by reference.

10. Registrant is not entitled to exclusive use of the term “ColorWorx” or “Color Works” and the design element in commerce for the services specified in U.S.

Registration No. 3,372,884.

11. The term “color works” obviously refers to works of color. According to dictionary definitions, both the words “color” and “works” are common and often-used words in the English language. Both the words “color” and “works” function as either verbs, adjectives or nouns. Moreover, in the Registrant’s Registration the words “color” and “works” can function as either verbs, adjectives or nouns to produce a name and description of goods and services which are generic and descriptive.

12. Registrant’s design element is not an original creation and minor variations thereof are used by other traders in the printing industry.

13. The words “color” and “works,” in respect to Registrant’s Registration, may be read, understood or interpreted a number of ways, with each word functioning as either a noun, verb or adjective to offer a commonly understood generic and descriptive version and purpose. Registrant’s Registration is therefore so highly descriptive as to be unprotectable.

14. A random search of the term "Color Works" on the google.com search engine showed 2,500,000 hits for web pages. A random search of the term "Color Worx" on the google.com search engine showed 4,630 hits for web pages. A random search of the word "ColorWorx" on the google.com search engine showed 24,600 hits for web pages.

15. The general public would not understand or believe that printing services offered in connection with the term “ColorWorx” and the design element refers to Registrant.

16. Registrant's design element, and minor variations thereof, are generic in the printing industry and do not distinguish Registrant's services from those of other traders. Other third parties use minor variations of Registrant's design element in their businesses.

17. The composite and compound word "ColorWorx" is generic for and easily recognizable as "color works" or works of color, and therefore generic with regard to printing services concerning such services and other closely related goods and services. When the two ordinary words "color" and "works" are joined into a compound, they form a phrase which has a commonly understood meaning, i.e., works of color.

18. Registrant cannot use the word "ColorWorx" as a trademark to indicate origin because "ColorWorx" is an insignificantly abbreviated and insignificantly misspelled composite of the words "color works," which are themselves generic. An abbreviation of a generic name which still conveys to the buyer the original generic connotation of the abbreviated name, is still "generic": *McCarthy on Trademarks*, pg 12-90; see also *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215 (C.C.P.A.1978). A misspelling of a generic name which does not change the generic significance to the buyer, is still generic: *American Aloe Corp. v Aloe Crème Laboratories, Inc.*, 420 F.2D 1248, 164 u.s.p.q. 266 (7th Cir. 1970). Registrant's Registration is neither distinctive, capable of distinguishing, fanciful, nor does it offer a different commercial impression to the term "color works," and therefore is not protectable.

19. The term "color works" is a name for goods and services offered by third party printers in general and third parties who trade in goods and services involving color in

particular and therefore is necessary for these third parties to conduct trade. Other third parties use this name.

20. Petitioner and other third parties have the right to use the term “color works” and the design element (and minor variations thereof) in connection with naming and advertising their printing services and other closely related goods and services.

21. If Registrant is allowed to continue to maintain its registration for COLORWORX and the design element, Registrant would be able to continue to improperly obstruct Petitioner’s and other third parties’ generic use of the term “color works” and the design element.

22. Because the term “COLORWORX” and the design element are incapable of serving as an indicator of source as applied to Ennis’ services, Registrant’s U.S. Registration No. 3,372,884 should be cancelled in the absence of a disclaimer of that portion.

COUNT II

REGISTRANT’S COLORWORX REGISTRATION SHOULD BE CANCELLED OR RESTRICTED AS THE TERM “COLORWORX” IS MERELY DESCRIPTIVE

15 U.S.C. § 1052 (e)

23. Petitioner incorporates all previous paragraphs by reference.

24. Registrant is not entitled to exclusive use of the term “ColorWorx” or “Color Works” and the design element in commerce for the services specified in U.S. Registration No. 3,372,884.

25. Registrant’s use of the term “ColorWorx” is not unique or distinctive, being an insignificant misspelling and abbreviated compound of the words “color works”, which are consistent with other third party and common understanding of the words dating back decades. The combination of the terms “color” and “works” to form “ColorWorx” fails to evoke a new and unique commercial impression, being merely descriptive. This slight misspelling of the word “works” does not turn a descriptive or generic word into a non-descriptive mark. *See C-Thru Ruler Co. v. Needleman*, (E.D. Pa. 1976). The addition of Registrant’s logo also fails to create a new and unique commercial impression, the logo being unremarkable, nondescript and non-distinctive.

26. The term “color works” is merely descriptive of the services recited in Registrant’s COLORWORX Registration or descriptive of a significant feature of the services because the term “ColorWorx” refers to the subject matter of Registrant’s services, that is color works produced by printing services. Matter that “merely describes” the goods or services on or in connection with which it is used is not registrable on the Principal Register. As noted in *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by

the registrant against others who use the mark when advertising or describing their own products.

27. In addition to being merely descriptive of printing services, Registrant's Registration ought not be registered on the Principal Register absent a showing of acquired distinctiveness under 15 U.S.C. §1052(f). Registrant has not shown such acquired distinctiveness for either the word COLORWORX or the design element and therefore registration should be cancelled.

28. Registrant's design element is not an original creation and minor variations thereof are used by other traders in the printing industry to describe, pictorially, their goods and services.

29. Registrant's design element, and minor variations thereof, are generic in the printing industry and do not distinguish Registrant's services from those of other traders. Other third parties use Registrant's design element or minor variations thereof in their businesses.

30. The term "color works" and the design element is necessary to accurately describe the subject matter of Petitioner's and other third parties' printing services and other closely and distantly related goods and services. Other third parties use this description and design element and/or minor variations thereof.

31. Petitioner and other third parties have the right to use the term "color works" and the design element in connection with describing the subject matter of their printing services and other closely and distantly related goods and services.

32. The term “ColorWorx” and the design element have not acquired distinctiveness or secondary meaning with respect to the services recited in Registrant’s U.S.

Registration No. 3,372,884.

33. If Registrant is allowed to continue to maintain its registration for COLORWORX and the design element, Registrant would be able to continue to improperly obstruct Petitioner’s and other third parties’ descriptive use of the term “color works.”

34. Because the term “COLORWORX” and the design element are merely descriptive of Registrant’s services, Registrant’s U.S. Registration No. 3,372,884 should be cancelled in the absence of a disclaimer of that portion.

COUNT III

REGISTRANT’S COLORWORX REGISTRATION SHOULD BE CANCELLED OR RESTRICTED BECAUSE IT IS NOT CAPABLE OF DISTINGUISHING REGISTRANT’S SERVICES

15 U.S.C. § 1091(a)

35. Petitioner incorporates all previous paragraphs by reference.

36. Registrant is not entitled to exclusive use of the term “ColorWorx” or “Color Works” and the design element in commerce for the services specified in U.S. Registration No. 3,372,884.

37. “ColorWorx,” being an insignificantly abbreviated and misspelled composite and compound of the term “color works,” frequently encompasses activities in the field of printing services and other closely and distantly related goods and services.

38. “Color works” is and has been for decades used as a common term for the services described in U.S. Registration No. 3,372,884 and other closely and distantly related goods and services.
39. Registrant’s design element is not an original creation and minor variations thereof are used by other traders in the printing industry to describe, pictorially, their goods and services.
40. Registrant’s design element is incapable of functioning as a trademark in the printing industry and does not distinguish Registrant’s services from those of other traders. Other third parties use Registrant’s design element or minor variations thereof in their businesses.
41. The Registrant’s use of the composite word “ColorWorx” is displayed in non-distinctive lettering and therefore has no capacity to distinguish the Registrant’s goods and services from those of other traders.
42. Because of the general nature of Registrant’s services - namely, the fact that “products are printed in 4-color process only” - and the fact that Registrant “is a ‘gang run’ style print company,” performing jobs “run on a press sheet with other jobs” which “will be run to standard color densities,” it is more important to distinguish its goods and services from those of other traders in general and other printers in particular. Registrant does not offer unique, individualized and/or customized products for its customers and because of its mass production or “gang run” commercial printing style, its Registration, namely the word COLORWORX and the design element, is more likely to be confused with the names of and goods and services offered by other traders in general and other printers in particular.

43. Because the term “ColorWorx” and the design element are incapable of functioning as a trademark as applied to Ennis’ services and are incapable of distinguishing Registrant’s services under 15 U.S.C. § 1091(a), U.S. Registration No. 3,372,884 should be cancelled in the absence of a disclaimer of that portion.

COUNT IV

REGISTRANT’S COLORWORX REGISTRATION AND DESIGN SHOULD BE CANCELLED OR RESTRICTED BECAUSE REGISTRANT PROCURED AND MAINTAINED SUCH REGISTRATION BY COMMITTING FRAUD ON THE UNITED STATES PATENT AND TRADEMARK OFFICE

15 U.S.C. §1064(3)

44. Petitioner incorporates by all paragraphs of his Petition by reference.

45. Pursuant to Fed. R. Civ. P. 9(b), it is alleged that Registrant and, where applicable, its attorneys (both past and current) knowingly made specific false and misleading material misrepresentations of fact regarding Registrant’s exclusive right to use the mark COLORWORX and design, in its application to register the mark COLORWORX and design with the intent to deceive the United States Patent and Trademark Office (USPTO) into issuing a registration.

46. The particularization of this alleged fraud committed by Registrant and, where applicable, its attorneys (both past and current), for each of the two portions of Registrant’s mark, namely the word COLORWORX and the design element, is found below.

47. It is further alleged that having fraudulently procured its registration of the COLORWORX mark and design from the USPTO, Registrant and, where applicable, its attorneys (both past and present) knowingly made specific false and misleading material misrepresentations of fact relating to the word COLORWORX and design, with the intent to deceive the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

48. The particularization of this alleged fraud committed by Registrant and, where applicable, its attorneys (both past and current) for the word COLORWORX and the design element, is found in sections IV(A) and IV(B).

Background to the Alleged Fraud

49. Registrant is in the business of manufacturing, designing, and selling business forms and other printed business products primarily to distributors located in the United States.

50. For many decades since its creation in 1909, Registrant was one of the nation's leaders in the manufacture of business forms.

51. Indeed, Registrant's name was at one stage Ennis Business Forms.

52. Registrant then changed its name to Ennis, dropping the words "Business Forms."

53. Since the digital age began, however, Registrant became aware that its core business, that is, the manufacture of standardized business forms, was becoming obsolete.

54. The drop in profits caused by the gradual obsolescence of its standardized forms business was a major blow to Registrant's business.

55. In order to offset the decreases in profits because of the obsolescence of Registrant's standardized business forms products, Registrant was eager to provide products which offered custom and color print jobs.

56. Improvements in the cost and quality of printing technology were enabling some of Registrant's competitors to gain access to products of complex design and functionality at competitive costs.

57. Registrant's competitors' access to improved printing technologies was one factor which forced Registrant to provide products and services which satisfy customers' short run color needs in order to enable Registrant's distributors to attract new customers and retain existing customers.

58. Registrant has faced the following challenges in the Print Segment of its business: transformation of your portfolio of products; excess production capacity and price competition within our industry; and economic uncertainties.

59. Because of the need to transform its portfolio of products, excess production capacity and price competition within your industry, and economic uncertainties, it was necessary for Registrant to take risks in order to gain a competitive edge.

60. Because of the need to transform Registrant's portfolio of products, excess production capacity and price competition within its industry, and economic uncertainties, it was necessary for Registrant to introduce new products within a short amount of time in order to enable its distributors to attract new customers and retain existing customers.

61. Registrant aimed to transform its product offerings to continue to provide innovative, unique and valuable solutions to Registrant's customers on a proactive basis.
62. But Registrant did not always achieve this goal.
63. It was not always possible for Registrant to expand its growth targeted products and develop new market niches.
64. As a result of intense competition in the printing industry and declining profits in the Print Segment, Registrant was more willing to take risks in developing custom and color print jobs.
65. Registrant's Print Segment faced intense competition to gain market share since its competition has often followed a strategy of selling their products at or below cost in order to cover some amount of fixed costs, especially in distressed economic times.
66. Registrant felt threatened by the competition posed by low price, high value office supply chain stores which offer standardized business forms, checks and related products.
67. There is intense competition in the printing industry with respect to the sale of presentation products.
68. Because of the threat posed by low price, high value office supply chain stores, Registrant was eager to provide products and services which satisfy customers' short run color needs in order to enable Registrant's distributors to attract new customers and retain existing customers.
69. Registrant's COLORWORX brand and design was one solution developed by Registrant to meet its short run color needs.
70. Goods and services Registrant sold under its "COLORWORX" brand were originally designed to serve the short run color needs of Registrant's distributors.

71. Registrant has used the slogan “Uniqueness is the mark of success” in relation to its business.

72. Registrant has used the slogan “Uniqueness is the mark of success” in relation to its business when it knew when it applied for and obtained the trademark registration for the COLORWORX mark with the United States Patent and Trademark Office that other traders use the marks “ColorWorx,” “Color Worx,” “Colorworks,” and/or “Color Works” marks in commerce in general and/or in the printing industry in particular in the United States.

73. Goods and services Registrant sold under the “COLORWORX” brand are currently designed to serve the short run color needs of Registrant’s distributors and private printers.

74. The downturn in the economy and turmoil in the credit markets in 2009 and 2010 have created highly competitive conditions in the printing industry in an already over-supplied, price-competitive industry.

75. The recessionary conditions of 2009 and 2010, and the resultant volatile and challenging economic climate had an adverse effect on Registrant’s business.

76. As a result of the recessionary conditions of 2009 and 2010, and the resultant volatile and challenging economic climate, Registrant was willing to take calculated risks in order to combat decreased demand and intense price competition.

77. Judging on net sales data in the Printing Segment for the 2011, 2010 and 2009 fiscal years, Registrant was not able, in the 2010 and 2011 fiscal years, to successfully combat the combined effect of the economic recession and the adoption of digital technologies.

78. The private printers and/or distributors Registrant sells its goods and services to in the United States possess specialized knowledge of the printing business, since they sell printed goods and printing services to their own customers.

79. Basing an Opposition to Petitioner's COLOR WARS mark on Registrant's COLORWORX logo and design was an action of bad faith by Registrant because it knew that Registrant's distributors and private printers are not everyday consumers or members of the public, but professional, experienced printers who have worked in the printing industry for many years.

**IV(A). ENNIS INC'S ALLEGED COMMISSION OF FRAUD IN PROCURING A
TRADEMARK REGISTRATION**

Alleged Fraud with respect to Registrant's Design Element

IV(A)1.

80. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

81. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar design element, namely the red circle and gray "X" design used by the Xerox Corporation (www.xerox.com), which also offers printing goods and services and is one of the leaders in the printing industry.

82. In its Response to Office Action dated September 11, 2006, Registrant described its crosshairs logo as an "X."

83. Registrant alleges that it first used its design element in August 2002 but, in Opposition No. 91203884, it refused and continues to refuse to disclose any information or evidence about its use save and except for product samples which do not bear a date.

84. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, the Xerox Corporation had legal rights superior to applicant's. The Xerox Corporation has been in business in the United States since 1906 and it is alleged that its use of its design element predates Registrant's.

85. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that the Xerox Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Both Registrant's and Xerox's design elements contain Xs and there is an obvious likelihood of confusion.

86. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose the above alleged facts to the USPTO, intended to deceive the USPTO and procure a registration to which it was not entitled.

IV(A)2.

87. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

88. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar design element, namely the crosshairs design used by the Four Colour Print Group (www.fourcolour.com), which also offers printing goods and services.

89. In its Response to Office Action dated September 11, 2006, Registrant described its design as a “crosshairs logo.”

90. Registrant alleges that it first used its design element in August 2002 but, in Opposition No. 91203884, it refused and continues to refuse to disclose any information or evidence about its use save and except for product samples which do not bear a date.

91. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, the Four Colour Print Group had legal rights superior to applicant's. The Four Colour Print Group has been in business in the United States since 1985 and it is alleged that its use of its design element predates Registrant's.

92. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that the Four Colour Print Group had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Both Registrant's and the Four Colour Print Group's design elements contain crosshairs logos and there is an obvious likelihood of confusion.

93. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose the above alleged facts to the USPTO, intended to deceive the USPTO and procure a registration to which it was not entitled.

IV(A)3.

94. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

95. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar design element, namely the crosshairs design used by Spectrum Color Printing & Mailing (www.spectrumcolorprinting.com), which also offers printing goods and services identical to registrant's such as flyers, brochures, booklets, posters, rack cards and doorhangers.

96. In its Response to Office Action dated September 11, 2006, Registrant described its design as a "crosshairs logo."

97. Registrant alleges that it first used its design element in August 2002 but, in Opposition No. 91203884, it refused and continues to refuse to disclose any information or evidence about its use save and except for product samples which do not bear a date.

98. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Spectrum Color Printing & Mailing had legal rights superior to applicant's. Spectrum Color Printing & Mailing has been in business in the United States since 1985 and it is alleged that its use of its design element predates Registrant's.

99. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Spectrum Color Printing & Mailing had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result

from applicant's use of its mark or had no reasonable basis for believing otherwise. Both Registrant's and Spectrum Color Printing & Mailing's design elements contain crosshairs logos and there is an obvious likelihood of confusion.

100. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose the above alleged facts to the USTO, intended to deceive the USPTO and procure a registration to which it was not entitled.

IV(A)4.

101. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

102. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar design element, namely the circle and "X" design used by the Microsoft Corporation (www.xbox.com), which is one of the leaders in the computing industry. Registrant's presentation products are based on digital and computing technology.

103. In its Response to Office Action dated September 11, 2006, Registrant described its crosshairs logo as an "X."

104. Registrant alleges that it first used its design element in August 2002 but, in Opposition No. 91203884, it refused and continues to refuse to disclose any information or evidence about its use save and except for product samples which do not bear a date.

105. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, the Microsoft Corporation had legal rights superior to applicant's. The Microsoft

Corporation has sold its X-box brand in the United States since 2001 and it is alleged that its use of its design element predates Registrant's.

106. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that the Microsoft Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Both Registrant's and Microsoft's design elements contain circles and Xs and there is an obvious likelihood of confusion.

107. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose the above alleged facts to the USPTO, intended to deceive the USPTO and procure a registration to which it was not entitled.

IV(A)5.

108. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

109. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar design element, namely the crosshairs logo used by Smartpress.com (www.smartpress.com), which offers printing products similar to Registrant.

110. In its Response to Office Action dated September 11, 2006, Registrant described its design element as a crosshairs logo.

111. Registrant alleges that it first used its design element in August 2002 but, in Opposition No. 91203884, it refused and continues to refuse to disclose any information or evidence about its use save and except for product samples which do not bear a date.

112. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Smartpress.com had legal rights superior to applicant's. Smartpress.com has sold its printing goods and services in the United States prior to August 2002 and it is alleged that its use of its design element predates Registrant's.

113. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Smartpress.com had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Both Registrant's and Smartpress.com's design elements contain crosshairs logos and there is an obvious likelihood of confusion.

114. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose the above alleged facts to the USPTO, intended to deceive the USPTO and procure a registration to which it was not entitled.

Alleged Fraud with respect to the word COLORWORX

IV(A)6.

115. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

116. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the mark "COLORWORKS" (<http://colorworksnyc.com/>), used in commerce by a New York company specializing in "Prints, Postcards, and Retouching." "Retoucher Joe Barna has over 30 years of experience retouching photography, twelve of which have been digital."

117. Registrant has alleged on oath in Opposition No. 91203884 that it works in the printing industry and that it produces postcards.

118. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Mr. Barna had legal rights superior to applicant's in that he has been using the mark since approximately the early 1980s.

119. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Mr. Barna had rights in the COLORWORX mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

120. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)7.

121. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's

application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

122. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the mark "COLORWORX" used in commerce by Creative Hairdressers Inc which on November 25, 1998, filed an Application to register the word COLORWORX² with the USPTO, and was assigned serial number 75595803 (*see* Exhibit 1).

123. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Creative Hairdressers Inc had legal rights superior to applicant's in that its goods and services were similar and/or closely related to Registrant's services.

124. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Creative Hairdressers Inc had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

125. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

² Although this application pertains to different goods and services than Registrant's services, it is respectfully submitted that this entry offers direct evidence that: 1) Registrant did not create the word "COLORWORX"; 2) that the compound word had the same meaning in 1998 that it has now, namely works of color; 3) Registrant has simply dishonestly misappropriated the mark of another user and passed it off as its own, falsely claiming exclusive rights to same.

IV(A)8.

126. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

127. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Clariant AG Corporation Switzerland.

128. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Clariant AG Corporation had legal rights superior to applicant's, in that it was the owner of Registration No.2783206 with respect to plastic coloration, which is similar and/or closely related to Registrant's services.

129. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Clariant AG Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Clariant AG Corporation's mark was registered on November 11, 2003, earlier than Registrant's registration date.

130. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)9.

131. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

132. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by New Order Organizers LLC.

133. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, New Order Organizers LLC had legal rights superior to applicant's, in that it used the COLORWORKS mark in commerce prior to Registrant's first use with respect to the almost identical printed goods which Registrant sells, including storage and organization systems comprising binders, folders, stickers, labels, adhesive notes.

134. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that New Order Organizers LLC had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

135. New Order Organizers LLC mark was registered on June 2, 2009 (Registration No.3632494); although this is later than Registrant's registration date, Registrant refuses to provide any evidence of the particulars of its alleged first use of the COLORWORX mark (if it has even used it at all), such as dates, places, media, sales figures, sales,

customers, geographical information, etc, casting massive doubt on the validity of Registrant's registration.

136. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)10.

137. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

138. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Horizon International Inc.

139. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Horizon International Inc had legal rights superior to applicant's, in that it was the owner of Registration No.2615133 with respect to apparatus, tools and machine tools, which are similar and/or closely related to Registrant's services.

140. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Horizon International Inc had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Horizon

International Inc mark was registered on September 3, 2002 with a filing date of October 17, 2001, earlier than Registrant's registration date.

141. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)11.

142. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

143. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "GALLERY COLORWORKS" owned by Tacony Corporation.

144. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Tacony Corporation had legal rights superior to applicant's, in that it was the owner of Registration No.2524890 with respect to computer software in relation to embroidering, which are similar and/or closely related to Registrant's services.

145. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Tacony Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Tacony

Corporation's mark was registered on January 1, 2002, with a filing date of February 5, 2001, earlier than Registrant's registration date.

146. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)12.

147. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

148. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Duncan Enterprises Corporation.

149. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Duncan Enterprises Corporation had legal rights superior to applicant's, in that first used the mark in commerce with respect to an instructional book for children in class 16, which is similar and/or closely related to Registrant's services.

150. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Duncan Enterprises Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Duncan

Enterprises Corporation's mark was first used in commerce in approximately May 2000, earlier than Registrant's registration date and alleged first use in commerce.

151. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)13.

152. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

153. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLOR WORKS" owned by Sherwin-Williams Automotive Finishes Corporation.

154. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Sherwin-Williams Automotive Finishes Corporation had legal rights superior to applicant's, in that it was the owner of Registration No.2453770 with respect to display racks for paint color cards, which are similar and/or closely related to Registrant's services.

155. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Sherwin-Williams Automotive Finishes Corporation had rights

in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Sherwin-Williams Automotive Finishes Corporation's mark was registered on May 22, 2001, earlier than Registrant's registration date.

156. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)14.

157. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

158. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Sherwin-Williams Automotive Finishes Corporation.

159. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Sherwin-Williams Automotive Finishes Corporation had legal rights superior to applicant's, in that it was the owner of Registration No.2476288 with respect to paint color cards, which are similar and/or closely related to Registrant's services.

160. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Sherwin-Williams Automotive Finishes Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Sherwin-Williams Automotive Finishes Corporation's mark was registered on March 28, 2000, earlier than Registrant's registration date.

161. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)15.

162. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

163. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLOR WORKS" owned by Deandra K. Vallier (Serial No. 75617896). Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Ms Vallier's mark is evidence to rebut this claim.

164. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Deandra K. Vallier had legal rights superior to applicant's, in that she used her mark on cosmetic eye drops, which are similar and/or closely related to Registrant's services.

165. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Deandra K. Vallier had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Deandra

K. Vallier mark was filed on January 12, 1999, earlier than Registrant's registration date.

166. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)16.

167. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

168. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLOR WORKS" owned by Mars Inc. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Mars Inc's mark is evidence to rebut this claim.

169. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Mars Inc. had legal rights superior to applicant's, in that it was the owner of Registration No.2451486 with respect to candy vending machines, which are similar and/or closely related to Registrant's services.

170. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Mars Inc. had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Mars Inc.'s mark was registered on May 15, 2001, earlier than Registrant's registration date.

171. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)17.

172. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

173. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Tarkett Inc.

174. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Tarkett Inc. had legal rights superior to applicant's, in that it was the owner of Registration No.2313535 with respect to sheet vinyl and vinyl tile flooring, which are similar and/or closely related to Registrant's services. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Tarkett Inc.'s mark is evidence to rebut this claim.

175. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Tarkett Inc. had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Tarkett Inc.'s mark was registered on February 1, 2000, earlier than Registrant's registration date.

176. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)18.

177. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

178. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use

in commerce of “COLORWORKS” owned by Mars Inc. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant’s adoption of it, and Mars Inc.’s mark is evidence to rebut this claim.

179. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Mars Inc. had legal rights superior to applicant's, in that it was the owner of Registration No.2103537 with respect to candy, which is similar and/or closely related to Registrant’s services.

180. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Mars Inc. had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Mars Inc.’s mark was registered on October 7, 1997, earlier than Registrant’s registration date.

181. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

182. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant’s application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

IV(A)19.

183. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant’s

application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

184. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Mars Inc. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Mars Inc.'s mark is evidence to rebut this claim.

185. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Mars Inc. had legal rights superior to applicant's, in that it was the owner of Registration No.2115953 with respect to display cases for candy products, which is similar and/or closely related to Registrant's services.

186. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Mars Inc. had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Mars Inc.'s mark was registered on November 25, 1997, earlier than Registrant's registration date.

187. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)20.

188. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's

application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

189. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLOR WORKS" owned by Deandra K. Vallier (Serial No. 75463213). Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Ms Vallier's mark is evidence to rebut this claim.

190. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Deandra K. Vallier had legal rights superior to applicant's, in that she used her mark on ophthalmic preparations, which are similar and/or closely related to Registrant's services.

191. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Deandra K. Vallier had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Deandra K. Vallier mark was filed on April 6, 1998, earlier than Registrant's registration date.

192. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)21.

193. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

194. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Owens-Corning Fibreglass Technology Inc. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Owens-Corning Fibreglass Technology Inc.'s mark is evidence to rebut this claim.

195. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Owens-Corning Fibreglass Technology Inc. had legal rights superior to applicant's, in that it used its mark in commerce with respect to computer programs for use in selecting color schemes for the exterior of a house, and roofing shingles, vinyl siding and non-metal windows and doors, which are similar and/or closely related to Registrant's services.

196. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Owens-Corning Fibreglass Technology Inc. had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

Owens-Corning Fibreglass Technology Inc. mark was filed on January 13, 1997 (serial number 75224752), earlier than Registrant's registration date.

197. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)22.

198. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

199. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Colorworks Collegiate Painters Inc. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Colorworks Collegiate Painters Inc.'s mark is evidence to rebut this claim.

200. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Colorworks Collegiate Painters Inc had legal rights superior to applicant's, in that it was the owner of Registration No.2210089 with respect to painting services, which are similar and/or closely related to Registrant's services.

201. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Colorworks Collegiate Painters Inc had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Colorworks Collegiate Painters Inc's mark was registered on December 15, 1998, earlier than Registrant's registration date.

202. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)23.

203. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

204. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Colorworks Film Graphics Corporation. Registrant has stated on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Colorworks Collegiate Painters Inc.'s mark is evidence to rebut this claim.

205. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Colorworks Film Graphics Corporation had legal rights superior to applicant's, in that it was the owner of Registration No. 2349187 with respect to computer generated color prints, which are similar and/or closely related to Registrant's services.

206. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Colorworks Film Graphics Corporation had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

Colorworks Film Graphics Corporation's mark was registered on May 16, 2000, earlier than Registrant's registration date.

207. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)24.

208. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed.

209. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark (not including the design element). Namely, the use in commerce of "COLORWORKS" owned by Circle of Beauty Inc. Registrant has stated

on oath that it invented the word COLORWORX, the word having no meaning prior to Registrant's adoption of it, and Circle of Beauty Inc.'s mark is evidence to rebut this claim.

210. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, Circle of Beauty Inc. had legal rights superior to applicant's, in that it was the owner of Registration No.2000638 with respect to cosmetics, which are similar and/or closely related to Registrant's services.

211. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that Circle of Beauty Inc. had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise. Circle of Beauty Inc.'s mark was registered on 17 September 1996, earlier than Registrant's registration date.

212. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

Alleged Fraud with respect to the word COLORWORX and design element

IV(A)25.

213. Following the ruling of the Board in *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), it is alleged that the declaration or oath in Registrant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar COLORWORX mark at the time the oath was signed.

214. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath there was in fact another use of the same or a confusingly similar mark to Registrant's COLORWORX mark and design. Namely, the mark "COLORWORX" and design used in commerce by a Californian printing company run by President and CEO, Shawn Barrett, which offers the identical services as Registrant ("Whether it be print, web design, logo creation, typesetting or branding, Colorworx is the only place you need to contact...With more than 10 years experience in the industry, our knowledge allows our clients to leave their projects in our hands and trust that they will be completed to the highest level of satisfaction") and uses the tagline "Printing made easy" (www.colorworx.ca).

215. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, the Californian print company using the word COLORWORX and design had legal rights superior to applicant's, insofar as this company had been using its COLORWORX mark and design for more than 10 years.

216. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant knew that the Californian print company had rights in the COLORWORX mark and design superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

217. In particular, it is alleged that at the time Registrant (then-Applicant) signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

IV(A)26.

218. Petitioner refers to sections IV(A)1-25 which are incorporated herein by reference.

219. It is alleged that, with respect to the above use of marks the same as or confusingly similar to Registrant's design element or marks the same as or confusingly similar to the word COLORWORX, Registrant's former attorney, Conrad C. Pitts, from the law firm Pitts and Eckls, P.C., personally signed the declaration or oath in Registrant's application for registration fraudulently, in that there was at least one other use of the same or a confusingly similar portion of Registrant's registered mark (that is, either the word COLORWORX or the design element) at the time the oath was signed, and that: at the time Mr. Pitts signed the oath there was in fact another use of the same or a confusingly similar portion of the mark; that at the time Mr. Pitts signed the oath, the other user had legal rights superior to applicant's; that at the time Mr. Pitts signed the oath, he knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that at the time Mr. Pitts signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

220. Petitioner's good faith basis for making the allegation of fraud against Mr. Pitts is that Registrant has refused and failed to produce the declaration or oath it made to the USPTO in its application to register the COLORWORX mark and design, despite numerous requests from Petitioner, which has necessitated a Motion to Compel in Opposition No. 91203884.

IV(A)27.

221. Petitioner refers to sections IV(A)1-26 which are incorporated herein by reference.

222. In the alternative to Section IV(A)26., it is alleged that, with respect to the above use of marks the same as or confusingly similar to Registrant's design element or marks the same as or confusingly similar to the word COLORWORX, Registrant's former attorney, Conrad C. Pitts, from the law firm Pitts and Eckls, P.C., suborned perjury by advising Applicant to signed the declaration or oath in Applicant's application for registration of the COLORWORX mark and design fraudulently, in that there was at least one other use of the same or a confusingly similar portion of Registrant's registered mark (that is, either the word COLORWORX or the design element) at the time the oath was signed, and that: at the time Mr. Pitts advised Applicant to sign the oath there was in fact another use of the same or a confusingly similar portion of the mark; that at the time Mr. Pitts advised applicant to sign the oath, the other user had legal rights superior to applicant's; that at the time Mr. Pitts advised applicant to sign the oath, he knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that at the time Mr. Pitts advised applicant to sign the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

223. Petitioner's good faith basis for making the allegation of subornation of perjury against Mr. Pitts is that Registrant has refused and failed to produce the declaration or oath it made to the USPTO in its application to register the COLORWORX mark and

design, despite numerous requests from Petitioner, which has necessitated a Motion to Compel in Opposition No. 91203884.

IV(A)28.

224. Petitioner refers to sections IV(A)1-27 which are incorporated herein by reference.

225. It is alleged that, with respect to the above use of marks the same as or confusingly similar to Registrant's design element or marks the same as or confusingly similar to the word COLORWORX, Registrant's former attorney, Sean L. Collin, from the law firm Pitts and Eckls, P.C., personally signed the declaration or oath in Registrant's application for registration fraudulently, in that there was at least one other use of the same or a confusingly similar portion of Registrant's registered mark (that is, either the word COLORWORX or the design element) at the time the oath was signed, and that: at the time Mr. Collin signed the oath there was in fact another use of the same or a confusingly similar portion of the mark; that at the time Mr. Collin signed the oath, the other user had legal rights superior to applicant's; that at the time Mr. Collin signed the oath, he knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that at the time Mr. Collin signed the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

226. Petitioner's good faith basis for making the allegation of fraud against Mr. Collin is that Registrant has refused and failed to produce the declaration or oath it made to the USPTO in its application to register the COLORWORX mark and design, despite

numerous requests from Petitioner, which has necessitated a Motion to Compel in Opposition No. 91203884.

IV(A)29.

227. Petitioner refers to sections IV(A)1-28 which are incorporated herein by reference.

228. In the alternative to Section IV(A)28., it is alleged that, with respect to the above use of marks the same as or confusingly similar to Registrant's design element or marks the same as or confusingly similar to the word COLORWORX, Registrant's former attorney, Sean L. Collin, from the law firm Pitts and Eckls, P.C., suborned perjury by advising Applicant to signed the declaration or oath in Applicant's application for registration of the COLORWORX mark and design fraudulently, in that there was at least one other use of the same or a confusingly similar portion of Registrant's registered mark (that is, either the word COLORWORX or the design element) at the time the oath was signed, and that: at the time Mr. Collin advised Applicant to sign the oath there was in fact another use of the same or a confusingly similar portion of the mark; that at the time Mr. Collin advised applicant to sign the oath, the other user had legal rights superior to applicant's; that at the time Mr. Collin advised applicant to sign the oath, he knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that at the time Mr. Collin advised applicant to sign the oath, applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

229. Petitioner's good faith basis for making the allegation of subornation of perjury against Mr. Collin is that Registrant has refused and failed to produce the declaration or oath it made to the USPTO in its application to register the COLORWORX mark and design, despite numerous requests from Petitioner, which has necessitated a Motion to Compel in Opposition No. 91203884.

IV(A)30.

230. Petitioner refers to sections IV(A)1-29 which are incorporated herein by reference.

231. It is alleged that Registrant (then-Applicant) and its past and present attorneys committed fraud on the USPTO by failing to take corrective action with respect to allegations of non-exclusivity of use of either the COLORWORX mark and/or the design element in that the USPTO in its Office Action(s) to Applicant advised Applicant that it had concerns about the non-exclusivity of use of the COLORWORX mark and/or the design element and Applicant failed to take corrective action by withdrawing its application for registration.

232. It is alleged that Applicant intended to deceive the USPTO by signing a false oath or declaration concerning Applicant's exclusive rights to use the COLORWORX mark and design element, with the dishonest intent of procuring a registration of the COLORWORX mark and design to which it was otherwise not entitled.

233. Since Applicant has failed to correct a false statement and take timely corrective action during *ex parte* prosecution, it is alleged that this failure to correct creates the presumption that Applicant had the requisite willful intent to deceive the USPTO

(*University Games Corp. v. 20Q.net Inc.*, Opposition Nos. 91168142 and 91170668, 87 USPQ2d 1465 (TTAB May 2, 2008).

IV(B). ENNIS INC'S ALLEGED COMMISSION OF FRAUD IN MAINTAINING
A TRADEMARK REGISTRATION

Alleged fraud with respect to Registrant's design element

IV(B)1.

234. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant knowingly made a specific false and misleading material misrepresentation of fact relating to the design element of Registrant's registration, thereby committing perjury, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

235. Petitioner (Applicant) served his First Request for Admissions on Opposer on May 10, 2012 through its attorneys in Opposition No. 91203884.

236. Registrant responded by serving its Objections and Responses to Applicant's First Request for Admissions on Applicant on June 11, 2012.

237. In Registrant's Notice of Opposition filed on February 15, 2012, there are two elements to trademark registration No. 3,372,884, upon which Opposer bases its Opposition: the word element, COLORWORX, and the design element, the "crosshairs"

logo (so called by Opposer in its Response to Office Action to the United States Patent and Trademark Office dated September 11, 2006).

238. REQUEST 25 of Applicant's First Request for Admissions to Opposer required Opposer to admit or deny the following:

Leaving aside, and independent of, the compound word "ColorWorx," the logo/design in Opposer's mark is highly distinctive and capable of distinguishing Opposer's goods and services from the goods and services of other traders.

239. In its Objections and Responses to Applicant's First Request for Admissions served on Applicant on June 11, 2012, Opposer answered the following:

Opposer objects to the request as it is irrelevant, harassing, and not reasonably calculated to lead to the discovery of evidence admissible at trial. Subject to, and without waiving, the foregoing objections, Opposer answers as follows: *Admit* (emphasis added).

240. It is alleged that that REQUEST 25 is highly relevant, probative, narrowly tailored, and is reasonably calculated to lead to the discovery of exactly the type of evidence admissible at trial.

241. In its Notice of Opposition, Opposer alleged in paragraphs 5-11 on pages 7 and 8 that:

5. Applicant's Mark so resembles Opposer's Mark that has been and is currently used, as to be likely to cause confusion, or cause mistake, or to deceive, in violation of Section 2(d) of The Trademark Act, 15 U.S.C. §1052(d), when used on or in connection with Applicant's Goods.

6. Under the circumstances, registration of Applicant's Mark will injure Opposer by causing the trade and/or purchasing public to be confused and/or deceived into believing that Applicant's Goods are those of Opposer or are sponsored by Opposer, to Opposer's damage and detriment, and will place a cloud over Opposer's title to its COLORWORX Mark in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

7. Opposer's COLORWORX Mark was well established long before the filing date of Applicant's subject application, and at the time that Applicant filed the subject Application. Registration of Applicant's Mark would diminish and dilute the distinctive quality of Opposer's rights in its COLORWORX Mark in violation of 15 U.S.C. §1125(c). Moreover, registration of Applicant's Mark would diminish the advertising value of Opposer's Mark, and such registration would, in the event of any quality problems involving the goods offered by Applicant, tarnish the distinctiveness of Opposer's Mark.
8. Applicant's Mark is the same as, or substantially the same as, Opposer's Mark, including in visual appearance and in pronunciation.
9. Applicant's Mark is likely to and/or has diluted and lessened the capacity of Opposer's Mark to identify and distinguish Opposer's Goods.
10. Applicant's Mark so resembles Opposer's continuously used and well-known Mark as to be likely, when used in connection with the goods as set forth in Applicant's application, to lessen the capacity of Opposer's Mark to identify and distinguish Opposer's Goods.
11. The subject application should be refused because Opposer's rights of continuing its present use of its Mark in commerce are, or would be, threatened by Applicant's registration of Applicant's Mark for Applicant's Goods, and because Opposer's business would otherwise be damaged by Applicant's registration of Applicant's Mark for Applicant's Goods.

242. In admitting that "the logo/design in Opposer's mark is highly distinctive and capable of distinguishing Opposer's goods and services from the goods and services of other traders," Registrant knowingly made a specific false and misleading material misrepresentation of fact relating to the design element of Registrant's registration, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design, for either Opposer believes the numerous allegations made in its Notice of Opposition, or Opposer believes that "the logo/design element in Opposer's mark is highly distinctive and capable of distinguishing Opposer's goods and services from the goods and services of other traders," in which

case there is absolutely no basis for filing the Notice of Opposition and pleading as Opposer pled.

243. The two positions are fundamentally incongruent and the only reasonable inference that may be drawn is that Registrant committed perjury and answered dishonestly and in bad faith to REQUEST 25 with an intent to deceive the USPTO into maintaining the COLORWORX registration and design.

IV(B)2.

244. Paragraphs 234-243 of section IVB(1) are incorporated herein by reference.

245. It is alleged that by advising Registrant to so admit REQUEST 25 of Applicant's First Request for Admissions to Opposer under oath, Registrant's attorney, Thomas G. Jacks, suborned perjury with the intent to deceive the USPTO into maintaining the registration of the COLORWORX mark and design element in that Mr. Jacks knew that the admission was a false and misleading material misrepresentation of fact in light of both a subjective and objective analysis of Registrant's design element and the Notice of Opposition Mr. Jacks filed on Registrant's behalf.

IV(B)3.

246. Paragraphs 234-243 of section IVB(1) are incorporated herein by reference.

247. It is alleged that by advising Registrant to so admit REQUEST 25 of Applicant's First Request for Admissions to Opposer under oath, Registrant's attorney, Scott A. Myer, suborned perjury with the intent to deceive the USPTO into maintaining the registration of the COLORWORX mark and design element in that Mr. Myer knew that

the admission was a false and misleading material misrepresentation of fact in light of both a subjective and objective analysis of Registrant's design element and the Notice of Opposition Mr. Myer filed on Registrant's behalf.

IV(B)4.

248. Paragraphs 234-243 of section IVB(1) are incorporated herein by reference.

249. It is alleged that by advising Registrant to so admit REQUEST 25 of Applicant's First Request for Admissions to Opposer under oath, Registrant's attorney, Edwin Flores, suborned perjury with the intent to deceive the USPTO into maintaining the registration of the COLORWORX mark and design element in that Mr. Flores knew that the admission was a false and misleading material misrepresentation of fact in light of both a subjective and objective analysis of Registrant's design element and the Notice of Opposition Mr. Flores filed on Registrant's behalf.

Alleged fraud with respect to the word COLORWORX

IV(B)5.

250. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant knowingly made a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

251. In Petitioner's First Set of Interrogatories to Registrant served on June 12, 2012, Registrant was asked the following Interrogatory:

INTERROGATORY NO. 8: Describe in detail how the compound word “COLORWORX” in your registration differs from the words “Color Works” in terms of meaning, appearance, sound and commercial impression.

252. In Registrant’s Objections and Answers to Petitioner’s First Set of Interrogatories dated July 13, 2012, Registrant answered as follows:

The mark “COLORWORX” differs from the words “Color Works” in terms of meaning, appearance, sound and commercial impression because the mark “COLORWORX” is a neologism and had no meaning prior to its adoption by Registrant.

253. In so answering, Registrant made a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because it did not in fact create the neologism/compound word COLORWORX.

254. In so answering, Registrant made a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because the neologism/compound word COLORWORX had a clear and unequivocal meaning prior to its adoption by Registrant.

255. In Opposition No. 91203884, Registrant answered under oath that its first use in commerce of the COLORWORX mark and design element was in August 2002, yet, despite only producing product samples relating to the COLORWORX mark and design element which do not bear any date, Registrant has refused and is refusing to disclose any further information about its registered mark. Petitioner has made numerous attempts to persuade Registrant to fully disclose and was forced to file a Motion to Compel.

256. Other traders who used the word COLORWORX prior to Registrant’s alleged first use in commerce in August 2002 (which cannot be proved because Registrant refuses to provide evidence of this) include, but are not limited to:

- a. Creative Hairdressers Inc which on November 25, 1998, filed an Application to register the word COLORWORX³ with the USPTO, and was assigned serial number 75595803 (*see* Exhibit 1);
- b. Colorworx Nursery⁴ (www.colorworxnursery.co.nz) in New Zealand, which “was started in 1974 in New Zealand by Dave and Adele Penn as a small family business;” and
- c. COLORWORX (www.colorworx.ca), a Californian printing company run by President and CEO, Shawn Barrett, which offers the identical services as Registrant (“Whether it be print, web design, logo creation, typesetting or branding, Colorworx is the only place you need to contact...With more than 10 years experience in the industry, our knowledge allows our clients to leave their projects in our hands and trust that they will be completed to the highest level of satisfaction”) and uses the tagline “Printing made easy.”

257. Other traders use and have used the words “Color Worx,” “Color Works,” and “ColorWorks” prior to Registrant’s first use. These uses have the same meaning and understanding as Registrant’s use of the word COLORWORX. An example is COLORWORKS (<http://colorworksnyc.com/>), a New York company specializing in “Prints, Postcards, and Retouching.” “Retoucher Joe Barna has over 30 years of experience retouching photography, twelve of which have been digital.” Registrant has

³ Although this application pertains to different goods and services than Registrant’s services, it is respectfully submitted that this entry offers direct evidence that Registrant did not create the word “COLORWORX” and that the compound word had the same meaning in 1998 that it has now, namely works of color.

⁴ Again, while this company sells different goods and services to Registrant’s services, it is respectfully submitted that this company is direct evidence that Registrant did not create the word “COLORWORX” and that the compound word had the same meaning in 1974 that it has now, namely works of color.

alleged on oath in Opposition No. 91203884 that it works in the printing industry and that it produces postcards.

IV(B)6.

258. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant's attorney, Mr. Edwin Flores, suborned perjury by advising Registrant to knowingly make a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Interrogatory No. 8 of Petitioner's First Set of Interrogatories to Registrant served on June 12, 2012 in Cancellation No. 92055374, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

259. Interrogatory No. 8 was in the following form:

INTERROGATORY NO. 8: Describe in detail how the compound word "COLORWORX" in your registration differs from the words "Color Works" in terms of meaning, appearance, sound and commercial impression.

260. In Registrant's Objections and Answers to Petitioner's First Set of Interrogatories dated July 13, 2012, Registrant answered as follows:

The mark "COLORWORX" differs from the words "Color Works" in terms of meaning, appearance, sound and commercial impression because the mark "COLORWORX" is a neologism and had no meaning prior to its adoption by Registrant.

261. In so answering, it is alleged that Mr. Flores suborned perjury by advising Registrant to make a knowingly false statement under oath with the intent to deceive both

petitioner and the USPTO because it did not in fact create the neologism/compound word COLORWORX.

262. In so answering, it is alleged that Mr. Flores suborned perjury by advising Registrant to make a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because the neologism/compound word COLORWORX had a clear and unequivocal meaning prior to its adoption by Registrant.

263. In Opposition No. 91203884, Registrant answered under oath that its first use in commerce of the COLORWORX mark and design element was in August 2002, yet, despite only producing product samples relating to the COLORWORX mark and design element which do not bear any date, Registrant has refused and is refusing to disclose any further information about its registered mark. Petitioner has made numerous attempts to persuade Registrant to fully disclose and was forced to file a Motion to Compel.

264. It is alleged that Mr. Flores formed a willful intent to deceive the USPTO by advising and conspiring with Registrant to commit fraud on the USPTO by refusing and failing to answer probative, highly relevant and specific discovery requests when Registrant was under a legal duty to answer and respond.

265. Other traders who used the word COLORWORX prior to Registrant's alleged first use in commerce in August 2002 (which cannot be proved because Registrant refuses to provide evidence of this) include, but are not limited to:

- a. Creative Hairdressers Inc. which on November 25, 1998, filed an Application to register the word COLORWORX⁵ with the USPTO, and was assigned serial number 75595803 (*see* Exhibit 1);

⁵ Although this application pertains to different goods and services than Registrant's services, it is respectfully submitted that this entry offers direct evidence that Registrant did not create the word

- b. Colorworx Nursery⁶ (www.colorworxnursery.co.nz) in New Zealand, which “was started in 1974 in New Zealand by Dave and Adele Penn as a small family business;” and
- c. COLORWORX (www.colorworx.ca), a Californian printing company run by President and CEO, Shawn Barrett, which offers the identical services as Registrant (“Whether it be print, web design, logo creation, typesetting or branding, Colorworx is the only place you need to contact...With more than 10 years experience in the industry, our knowledge allows our clients to leave their projects in our hands and trust that they will be completed to the highest level of satisfaction”) and uses the tagline “Printing made easy.”

266. Mr. Flores, as Registrant’s attorney of record, is intimately aware of, and has specific knowledge of, these other traders, because, as part of his due diligence representing Registrant, he searched the internet by typing in the word “COLORWORX” and read the results.

267. Mr. Flores is also intimately aware of, and has specific knowledge of, the application to register the COLORWORX mark by Creative Hairdressing Inc (serial number 75595803), because, as part of his due diligence representing Registrant, he searched the USPTO’s online database and read the results.

268. Moreover, Mr. Flores, as part of his due diligence representing Registrant, searched the USPTO database for the words “COLOR WORX,” “COLOR WORKS,” and “COLOR WORKS” and read the results.

“COLORWORX” and that the compound word had the same meaning in 1998 that it has now, namely works of color.

⁶ Again, while this company sells different goods and services to Registrant’s services, it is respectfully submitted that this company is direct evidence that Registrant did not create the word “COLORWORX” and that the compound word had the same meaning in 1974 that it has now, namely works of color.

269. In addition, Mr. Flores, as part of his due diligence representing Registrant, searched the internet for the words “COLOR WORX,” “COLOR WORKS,” and “COLOR WORKS” and read the results.

270. Other traders use and have used the words “Color Worx,” “Color Works,” and “ColorWorks” prior to Registrant’s first use. These uses have the same meaning and understanding as Registrant’s use of the word COLORWORX. An example is COLORWORKS (<http://colorworksnyc.com/>), a New York company specializing in “Prints, Postcards, and Retouching.” “Retoucher Joe Barna has over 30 years of experience retouching photography, twelve of which have been digital.” Registrant has alleged on oath in Opposition No. 91203884 that it works in the printing industry and that it produces postcards.

271. An attorney’s duty of competence aside, it is respectfully submitted that an eight year old child could ascertain, through a simple Google search of the word COLORWORX, that Registrant did not create the word COLORWORX or have exclusive rights to its use with respect to printing services.

272. Both the internet search and the USPTO database search allegedly yielded results which would have thrown significant doubt on Mr. Flores’ belief that Registrant created the word COLORWORX and/or had exclusive rights to its use with respect to printing services.

273. It is alleged that Mr. Flores either knew Registrant was answering its Interrogatory falsely and dishonestly conspired with Registrant or suborned perjury and advised Registrant to make a specific false and misleading material misrepresentation of

fact under oath with the intent to deceive both petitioner and the USPTO into maintaining Registrant's COLORWORX registration and design.

IV(B)7.

274. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant's attorney, Mr. Scott A. Myer, suborned perjury by advising Registrant to knowingly make a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Interrogatory No. 8 of Petitioner's First Set of Interrogatories to Registrant served on June 12, 2012 in Cancellation No. 92055374, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

275. Interrogatory No. 8 was in the following form:

INTERROGATORY NO. 8: Describe in detail how the compound word "COLORWORX" in your registration differs from the words "Color Works" in terms of meaning, appearance, sound and commercial impression.

276. In Registrant's Objections and Answers to Petitioner's First Set of Interrogatories dated July 13, 2012, Registrant answered as follows:

The mark "COLORWORX" differs from the words "Color Works" in terms of meaning, appearance, sound and commercial impression because the mark "COLORWORX" is a neologism and had no meaning prior to its adoption by Registrant.

277. In so answering, it is alleged that Mr. Myer suborned perjury by advising Registrant to make a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because it did not in fact create the neologism/compound word COLORWORX.

278. In so answering, it is alleged that Mr. Myer suborned perjury by advising Registrant to make a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because the neologism/compound word COLORWORX had a clear and unequivocal meaning prior to its adoption by Registrant.

279. In Opposition No. 91203884, Registrant answered under oath that its first use in commerce of the COLORWORX mark and design element was in August 2002, yet, despite only producing product samples relating to the COLORWORX mark and design element which do not bear any date, Registrant has refused and is refusing to disclose any further information about its registered mark. Petitioner has made numerous attempts to persuade Registrant to fully disclose and was forced to file a Motion to Compel.

280. It is alleged that Mr. Myer formed a willful intent to deceive the USPTO by advising and conspiring with Registrant to commit fraud on the USPTO by refusing and failing to answer probative, highly relevant and specific discovery requests when Registrant was under a legal duty to answer and respond.

281. Other traders who used the word COLORWORX prior to Registrant's alleged first use in commerce in August 2002 (which cannot be proved because Registrant refuses to provide evidence of this) include, but are not limited to:

- a. Creative Hairdressers Inc. which on November 25, 1998, filed an Application to register the word COLORWORX⁷ with the USPTO, and was assigned serial number 75595803 (*see* Exhibit 1);

⁷ Although this application pertains to different goods and services than Registrant's services, it is respectfully submitted that this entry offers direct evidence that Registrant did not create the word "COLORWORX" and that the compound word had the same meaning in 1998 that it has now, namely works of color.

- b. Colorworx Nursery⁸ (www.colorworxnursery.co.nz) in New Zealand, which “was started in 1974 in New Zealand by Dave and Adele Penn as a small family business;” and
- c. COLORWORX (www.colorworx.ca), a Californian printing company run by President and CEO, Shawn Barrett, which offers the identical services as Registrant (“Whether it be print, web design, logo creation, typesetting or branding, Colorworx is the only place you need to contact...With more than 10 years experience in the industry, our knowledge allows our clients to leave their projects in our hands and trust that they will be completed to the highest level of satisfaction”) and uses the tagline “Printing made easy.”

282. Mr. Myer is intimately aware of, and has specific knowledge of, these other traders, because, as part of his due diligence representing Registrant, he searched the internet by typing in the word “COLORWORX” and read the results.

283. Mr. Myer is also intimately aware of, and has specific knowledge of, the application to register the COLORWORX mark by Creative Hairdressing Inc (serial number 75595803), because, as part of his due diligence representing Registrant, he searched the USPTO’s online database and read the results.

284. Moreover, Mr. Myer, as part of his due diligence representing Registrant, searched the USPTO database for the words “COLOR WORX,” “COLOR WORKS,” and “COLOR WORKS” and read the results.

⁸ Again, while this company sells different goods and services to Registrant’s services, it is respectfully submitted that this company is direct evidence that Registrant did not create the word “COLORWORX” and that the compound word had the same meaning in 1974 that it has now, namely works of color.

285. In addition, Mr. Myer, as part of his due diligence representing Registrant, searched the internet for the words “COLOR WORX,” “COLOR WORKS,” and “COLOR WORKS” and read the results.

286. Other traders use and have used the words “Color Worx,” “Color Works,” and “ColorWorks” prior to Registrant’s first use. These uses have the same meaning and understanding as Registrant’s use of the word COLORWORX. An example is COLORWORKS (<http://colorworksnyc.com/>), a New York company specializing in “Prints, Postcards, and Retouching.” “Retoucher Joe Barna has over 30 years of experience retouching photography, twelve of which have been digital.” Registrant has alleged on oath in Opposition No. 91203884 that it works in the printing industry and that it produces postcards.

287. An attorney’s duty of competence aside, it is respectfully submitted that an eight year old child could ascertain, through a simple Google search of the word COLORWORX, that Registrant did not create the word COLORWORX or have exclusive rights to its use with respect to printing services.

288. Both the internet search and the USPTO database search allegedly yielded results which would have thrown significant doubt on Mr. Myer’s belief that Registrant created the word COLORWORX and/or had exclusive rights to its use with respect to printing services.

289. It is alleged that Mr. Myer either knew Registrant was answering its Interrogatory falsely and dishonestly conspired with Registrant or suborned perjury and advised Registrant to make a specific false and misleading material misrepresentation of fact

under oath with the intent to deceive both petitioner and the USPTO into maintaining Registrant's COLORWORX registration and design.

IV(B)8.

290. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant's attorney, Mr. Thomas G. Jacks, suborned perjury by advising Registrant to knowingly make a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Interrogatory No. 8 of Petitioner's First Set of Interrogatories to Registrant served on June 12, 2012 in Cancellation No. 92055374, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

291. Interrogatory No. 8 was in the following form:

INTERROGATORY NO. 8: Describe in detail how the compound word "COLORWORX" in your registration differs from the words "Color Works" in terms of meaning, appearance, sound and commercial impression.

292. In Registrant's Objections and Answers to Petitioner's First Set of Interrogatories dated July 13, 2012, Registrant answered as follows:

The mark "COLORWORX" differs from the words "Color Works" in terms of meaning, appearance, sound and commercial impression because the mark "COLORWORX" is a neologism and had no meaning prior to its adoption by Registrant.

293. In so answering, it is alleged that Mr. Jacks suborned perjury by advising Registrant to make a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because it did not in fact create the neologism/compound word COLORWORX.

294. In so answering, it is alleged that Mr. Jacks suborned perjury by advising Registrant to make a knowingly false statement under oath with the intent to deceive both petitioner and the USPTO because the neologism/compound word COLORWORX had a clear and unequivocal meaning prior to its adoption by Registrant.

295. In Opposition No. 91203884, Registrant answered under oath that its first use in commerce of the COLORWORX mark and design element was in August 2002, yet, despite only producing product samples relating to the COLORWORX mark and design element which do not bear any date, Registrant has refused and is refusing to disclose any further information about its registered mark. Petitioner has made numerous attempts to persuade Registrant to fully disclose and was forced to file a Motion to Compel.

296. It is alleged that Mr. Jacks formed a willful intent to deceive the USPTO by advising and conspiring with Registrant to commit fraud on the USPTO by refusing and failing to answer probative, highly relevant and specific discovery requests when Registrant was under a legal duty to answer and respond.

297. Other traders who used the word COLORWORX prior to Registrant's alleged first use in commerce in August 2002 (which cannot be proved because Registrant refuses to provide evidence of this) include, but are not limited to:

- a Creative Hairdressers Inc. which on November 25, 1998, filed an Application to register the word COLORWORX⁹ with the USPTO, and was assigned serial number 75595803 (*see* Exhibit 1);

⁹ Although this application pertains to different goods and services than Registrant's services, it is respectfully submitted that this entry offers direct evidence that Registrant did not create the word "COLORWORX" and that the compound word had the same meaning in 1998 that it has now, namely works of color.

- b. Colorworx Nursery¹⁰ (www.colorworxnursery.co.nz) in New Zealand, which “was started in 1974 in New Zealand by Dave and Adele Penn as a small family business;” and
- c. COLORWORX (www.colorworx.ca), a Californian printing company run by President and CEO, Shawn Barrett, which offers the identical services as Registrant (“Whether it be print, web design, logo creation, typesetting or branding, Colorworx is the only place you need to contact... With more than 10 years experience in the industry, our knowledge allows our clients to leave their projects in our hands and trust that they will be completed to the highest level of satisfaction”) and uses the tagline “Printing made easy.”

298. Mr. Jacks is intimately aware of, and has specific knowledge of, these other traders, because, as part of his due diligence representing Registrant, he searched the internet by typing in the word “COLORWORX” and read the results.

299. Mr. Jacks is also intimately aware of, and has specific knowledge of, the application to register the COLORWORX mark by Creative Hairdressing Inc (serial number 75595803), because, as part of his due diligence representing Registrant, he searched the USPTO’s online database and read the results.

300. Moreover, Mr. Jacks, as part of his due diligence representing Registrant, searched the USPTO database for the words “COLOR WORX,” “COLOR WORKS,” and “COLOR WORKS” and read the results.

¹⁰ Again, while this company sells different goods and services to Registrant’s services, it is respectfully submitted that this company is direct evidence that Registrant did not create the word “COLORWORX” and that the compound word had the same meaning in 1974 that it has now, namely works of color.

301. In addition, Mr. Jacks, as part of his due diligence representing Registrant, searched the internet for the words “COLOR WORX,” “COLOR WORKS,” and “COLOR WORKS” and read the results.

302. Other traders use and have used the words “Color Worx,” “Color Works,” and “ColorWorks” prior to Registrant’s first use. These uses have the same meaning and understanding as Registrant’s use of the word COLORWORX. An example is COLORWORKS (<http://colorworksnyc.com/>), a New York company specializing in “Prints, Postcards, and Retouching.” “Retoucher Joe Barna has over 30 years of experience retouching photography, twelve of which have been digital.” Registrant has alleged on oath in Opposition No. 91203884 that it works in the printing industry and that it produces postcards.

303. An attorney’s duty of competence aside, it is respectfully submitted that an eight year old child could ascertain, through a simple Google search of the word COLORWORX, that Registrant did not create the word COLORWORX or have exclusive rights to its use with respect to printing services.

304. Both the internet search and the USPTO database search allegedly yielded results which would have thrown significant doubt on Mr. Jacks’ belief that Registrant created the word COLORWORX and/or had exclusive rights to its use with respect to printing services.

305. It is alleged that Mr. Jacks either knew Registrant was answering its Interrogatory falsely and dishonestly conspired with Registrant or suborned perjury and advised Registrant to make a specific false and misleading material misrepresentation of fact

under oath with the intent to deceive both petitioner and the USPTO into maintaining Registrant's COLORWORX registration and design.

Alleged fraud with respect to the word COLORWORX and the design element

IV(B)9.

306. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant knowingly made a number of specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its Notice of Opposition in Opposition No. 91203884, with the intent to deceive both Petitioner and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

307. In particular, it is alleged that Registrant knowingly made a number of specific false and misleading material misrepresentations of fact with respect to the sales, reputation, recognition, advertising, promotion, goodwill, secondary meaning, continuous use, mistake, confusion, deception, diminishment, dilution and rights of its COLORWORX mark and design.

308. It is alleged that with respect to these allegations contained in its Notice of Opposition, Registrant has then deceptively and in bad faith refused to support its Opposition with relevant and specific evidence of these allegations, as well as refusing to answer and respond to vast majority of Discovery requests served on Registrant in relation to these allegations.

309. By making these allegations in its Notice of Opposition, Registrant intended to deceive Petitioner (Applicant) into withdrawing his bona fide application for registration

of the COLOR WARS mark, and thereby, intended to deceive the USPTO into believing that the COLORWORX registration and design element were “valid, subsisting, and in full force and effect,” which would have maintained the registration with the USPTO.

IV(B)10.

310. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant knowingly made a number of specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its Notice of Opposition in Opposition No.91203773, with the intent to deceive both the Applicant, the Pioneer Supply Company, and the USPTO into maintaining Registrant’s registration of the COLORWORX mark and design.

311. In particular, it is alleged that Registrant knowingly made a number of specific false and misleading material misrepresentations of fact with respect to the sales, reputation, recognition, advertising, promotion, goodwill, secondary meaning, continuous use, mistake, confusion, deception, diminishment, dilution and rights of its COLORWORX mark and design.

312. It is alleged that with respect to these allegations contained in its Notice of Opposition, Registrant has then deceptively and in bad faith refused to support its Opposition with relevant and specific evidence of these allegations, as well as refusing to answer and respond to vast majority of Discovery requests served on Registrant in relation to these allegations.

313. By making these allegations in its Notice of Opposition, Registrant intended to deceive the Applicant into withdrawing his bona fide application for registration of the

PSC COLOR WORKS mark, and thereby, intended to deceive the USPTO into believing that the COLORWORX registration and design element were “valid, subsisting, and in full force and effect,” which would have maintained the registration with the USPTO.

IV(B)11.

314. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant knowingly made a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Request to Produce No.6 of Applicant’s First Request for Production in Opposition No. 91203884 dated June 11, 2012, with the intent to deceive both Petitioner (Applicant) and the USPTO into maintaining Registrant’s registration of the COLORWORX mark and design.

315. **REQUEST TO PRODUCE NO. 6** was in the following form:

Produce copies of complaints or petitions in any action filed by or against You in which the allegations are similar to those of this suit.

Registrant’s response was as follows:

Opposer objects to this Request as Applicant has equal or greater access to the complaint or petition filed in *Joel L. Beling d/b/a Supa Characters Pty Ltd v. Ennis Inc.*; Cancellation No. 92055374.

316. In so answering, it is alleged that Registrant intended to deceive Petitioner and the USPTO in maintaining its registration of the COLORWORX mark and design element. Registrant claims the exclusive right to use the mark COLORWORX in related to printing goods and services and has filed at least two Opposition proceedings with the USPTO against traders whose marks call into question, create conflict in respect of, or challenge Opposer’s right to use the COLORWORX mark. The two Opposition

proceedings are Opposition No. 91203884, which Registrant referred to in its answer, and Opposition No. 91203773, which Registrant filed against the “PSC COLOR WORKS” mark, which was applied for by the Pioneer Supply Company, which Registrant simply omitted to mention.

317. It is alleged that Registrant’s Attorney Thomas G. Jacks referred to this proceeding in the Discovery Conference which Elizabeth Dunn, attorney for the board, participated in on April 24, 2012 together with Petitioner (Applicant). Mr. Jacks obviously had and has intimate knowledge of Opposition No. 91203773 and yet he and his law firm failed to answer any questions and produce any documents relating to this action. The corollary is that Opposer and its attorneys are attempting to conceal fraud and have engaged in a conspiracy to commit fraud. If Opposer and its attorneys refuse to answer even basis questions about the COLORWORX mark, in respect of which there is independent, TTAB-corroborated evidence, there is no telling what lengths Opposer and its attorneys will go to conceal fraud and perpetuate the conspiracy to commit fraud.

318. It is alleged that in refusing to disclose the existence of Opposition No. 91203773, and instead only referring to Opposition No. 91203884, Registrant has intended to deceive the USPTO and committed perjury.

IV(B)12.

319. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant’s attorney, Mr. Scott A. Myer, suborned perjury by advising Registrant to knowingly make a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Request to Produce No.6 of Applicant’s First Request for Production in Opposition No. 91203884

dated June 11, 2012, with the intent to deceive both Petitioner (Applicant) and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

320. **REQUEST TO PRODUCE NO. 6** was in the following form:

Produce copies of complaints or petitions in any action filed by or against You in which the allegations are similar to those of this suit.

Registrant's response was as follows:

Opposer objects to this Request as Applicant has equal or greater access to the complaint or petition filed in *Joel L. Beling d/b/a Supa Characters Pty Ltd v. Ennis Inc.*; Cancellation No. 92055374.

321. In so answering, it is alleged that Mr. Myer intended to deceive Petitioner and the USPTO in maintaining its registration of the COLORWORX mark and design element. Registrant claims the exclusive right to use the mark COLORWORX in related to printing goods and services and has filed at least two Opposition proceedings with the USPTO against traders whose marks call into question, create conflict in respect of, or challenge Opposer's right to use the COLORWORX mark. The two Opposition proceedings are Opposition No. 91203884, which Registrant referred to in its answer, and Opposition No. 91203773, which Registrant filed against the "PSC COLOR WORKS" mark, which was applied for by the Pioneer Supply Company, which Registrant simply omitted to mention. Mr. Myer is intimately aware of, and has specific knowledge of, these facts and the associated files.

322. It is alleged that Mr. Thomas Jacks, Mr. Myer's law partner, referred to this proceeding in the Discovery Conference which Elizabeth Dunn, attorney for the board, participated in on April 24, 2012 together with Petitioner (Applicant).

323. It is alleged that in refusing to disclose the existence of Opposition No. 91203773, and instead only referring to Opposition No. 91203884, Registrant's Attorney, Mr. Scott A. Myer, has failed to comply with a legal duty to disclose, and has intended to deceive the USPTO, and suborned perjury.

IV(B)13.

324. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant's attorney, Mr. Thomas G. Jacks, suborned perjury by advising Registrant to knowingly make a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Request to Produce No.6 of Applicant's First Request for Production in Opposition No. 91203884 dated June 11, 2012, with the intent to deceive both Petitioner (Applicant) and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

325. **REQUEST TO PRODUCE NO. 6** was in the following form:

Produce copies of complaints or petitions in any action filed by or against
You in which the allegations are similar to those of this suit.

Registrant's response was as follows:

Opposer objects to this Request as Applicant has equal or greater access to the complaint or petition filed in *Joel L. Beling d/b/a Supa Characters Pty Ltd v. Ennis Inc.*; Cancellation No. 92055374.

326. In so answering, it is alleged that Mr. Jacks intended to deceive Petitioner and the USPTO in maintaining its registration of the COLORWORX mark and design element. Registrant claims the exclusive right to use the mark COLORWORX in related to printing goods and services and has filed at least two Opposition proceedings with the

USPTO against traders whose marks call into question, create conflict in respect of, or challenge Opposer's right to use the COLORWORX mark. The two Opposition proceedings are Opposition No. 91203884, which Registrant referred to in its answer, and Opposition No. 91203773, which Registrant filed against the "PSC COLOR WORKS" mark, which was applied for by the Pioneer Supply Company, which Registrant simply omitted to mention. Mr. Jacks is intimately aware of, and has specific knowledge of, these facts and the associated files.

327. It is alleged that Mr. Jacks referred to this proceeding in the Discovery Conference which Elizabeth Dunn, attorney for the board, participated in on April 24, 2012 together with Petitioner (Applicant).

328. It is alleged that in refusing to disclose the existence of Opposition No. 91203773, and instead only referring to Opposition No. 91203884, Registrant's Attorney, Mr. Thomas G. Jacks, has failed to comply with a legal duty to disclose, and has intended to deceive the USPTO, and suborned perjury.

IV(B)14.

329. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant's attorney, Mr. Edwin Flores, suborned perjury by advising Registrant to knowingly make a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Request to Produce No.6 of Applicant's First Request for Production in Opposition No. 91203884 dated June 11, 2012, with the intent to deceive both Petitioner (Applicant) and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

330. **REQUEST TO PRODUCE NO. 6** was in the following form:

Produce copies of complaints or petitions in any action filed by or against
You in which the allegations are similar to those of this suit.

Registrant's response was as follows:

Opposer objects to this Request as Applicant has equal or greater access to the complaint or petition filed in *Joel L. Beling d/b/a Supa Characters Pty Ltd v. Ennis Inc.*; Cancellation No. 92055374.

331. In so answering, it is alleged that Mr. Flores intended to deceive Petitioner and the USPTO in maintaining its registration of the COLORWORX mark and design element. Registrant claims the exclusive right to use the mark COLORWORX in related to printing goods and services and has filed at least two Opposition proceedings with the USPTO against traders whose marks call into question, create conflict in respect of, or challenge Opposer's right to use the COLORWORX mark. The two Opposition proceedings are Opposition No. 91203884, which Registrant referred to in its answer, and Opposition No. 91203773, which Registrant filed against the "PSC COLOR WORKS" mark, which was applied for by the Pioneer Supply Company, which Registrant simply omitted to mention. Mr. Flores, as Registrant's attorney of record, is intimately aware of, and has specific knowledge of, these facts and the associated files.

332. It is alleged that Mr. Thomas Jacks, Mr. Flores' law partner, referred to this proceeding in the Discovery Conference which Elizabeth Dunn, attorney for the board, participated in on April 24, 2012 together with Petitioner (Applicant).

333. It is alleged that in refusing to disclose the existence of Opposition No. 91203773, and instead only referring to Opposition No. 91203884, Registrant's Attorney, Mr. Edwin Flores, has failed to comply with a legal duty to disclose, and has intended to deceive the USPTO, and suborned perjury.

IV(B)15.

334. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant and its attorneys, Chalker Flores LLP, willfully intended to deceive Petitioner and the USPTO as to the maintenance and continuing validity of Registrant's COLORWORX mark and design by dishonestly attempting to persuade Petitioner to accept two settlement offers dated June 21, 2012 and June 25, 2012, in Opposition No. 91203884, when Registrant and its attorneys knew in fact that they had filed a frivolous, unmeritorious, Opposition in bad faith based on a fraudulently obtained registration and that Petitioner had become aware of such fraud.

335. In such settlement offers, Registrant and its attorneys knowingly made specific false and misleading material misrepresentations of fact relating to the validity and effect of the COLORWORX mark and design element.

IV(B)16.

336. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant and its attorneys, Chalker Flores LLP (especially Mr. Thomas Jacks), in an email to Petitioner on June 28, 2012, willfully intended to deceive Petitioner and the USPTO as to the maintenance and continuing validity of Registrant's COLORWORX mark and design by dishonestly attempting to persuade Petitioner to "not involve the TTAB in this matter" (Opposition No. 91203884), when Registrant and its attorneys knew in fact that they had filed a frivolous, unmeritorious, Opposition in bad faith based on a fraudulently obtained registration.

337. In this email, Registrant and its attorneys knowingly made numerous specific false and misleading material misrepresentations of fact relating to the validity and effect of the COLORWORX mark and design element.

338. One example is the following: "...we [Registrant and its attorneys] are actively searching for additional documents and will continue to supplement our production according to the Federal Rules of Civil Procedure." To date there has been no additional supplementation of Registrant's legally insufficient discovery responses.

339. The email also accuses Petitioner of "lack of professionalism" in pursuing legitimate, probative and relevant Discovery requests when Registrant and its attorneys know that Petitioner is not an attorney and has had no prior experience dealing with American laws or the American legal system.

340. It is also submitted that Registrant and attorneys manifested an intent to deceive Petitioner and the USPTO by alleging that "We have treated you with respect and our actions have been ethical and professional," when in fact the opposite is the case.

341. Finally, it is alleged that Registrant and its attorneys manifested an intent to deceive Petitioner and the USPTO by alleging that Petitioner has "disparage[d] our client and our firm" and that if such disparagement continues, Registrant and its attorneys will involve the TTAB.

342. It is alleged that if a legally naïve person received this correspondence, he or she would have desisted in pursuing their legal rights. However, because Petitioner has some legal experience, albeit not with the U.S. legal system, it is clear that such a correspondence is manipulative, factually inaccurate and manifests a clear intent to

deceive Petitioner and the USPTO regarding the maintenance of Registrant's COLORWORX mark and design through the use of scare tactics and empty threats.

IV(B)17.

343. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant and its attorneys clearly understood the legal significance, consequences and implications of statements in Registrant's Section 8 Declaration but willfully and dishonestly intended to deceive the USPTO with respect to the maintenance of the COLORWORX registration and design by making false and misleading material misrepresentations of fact in relation to the exclusive right to use the COLORWORX mark and design as particularized in sections IV(A) and IV(B) of this document (*Jimlar Corp. v. Montrexpert S.P.A.*, Cancellation No. 92032471 (TTAB June 4, 2004)).

IV(B)18.

344. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant knowingly made a specific false and misleading material misrepresentation of fact relating to the COLORWORX mark in its response to Request to Produce No.8 of Applicant's First Request for Production in Opposition No. 91203884 dated June 11, 2012, with the intent to deceive both Petitioner (Applicant) and the USPTO into maintaining Registrant's registration of the COLORWORX mark and design.

345. **REQUEST TO PRODUCE NO. 8** was in the following form:

Produce all oral or written statements made by You or Your representatives concerning this suit.

Registrant's response was as follows:

None.

346. In so answering, it is alleged that Registrant intended to deceive Petitioner and the USPTO in maintaining its registration of the COLORWORX mark and design element.

347. Registrant's answer is patently false and perjurious because, if true, it assumes there was never any written or email correspondence between Registrant's attorneys and between Registrant and Registrant's attorneys regarding any matter in Opposition No. 91203884.

348. Even if every single written communication was subject to the attorney-client privilege or the work product privilege, Registrant and its attorneys had a duty to disclose the date, author, recipient and general summary of the communication. They failed to do this.

349. Indeed, in Opposition No. 91203884, before Petitioner filed his Motion to Amend Pleadings to include an allegation of fraud against Registrant in his Petition to Cancel, Petitioner wrote to Registrant's attorneys and asked them whether such an amendment could be done by consent.

350. Registrant consulted with its attorneys and, approximately 10 days later, replied via email that it did not consent to the fraud allegation.

351. Petitioner's fraud allegation would have generated a flurry of emails amidst Registrant's senior management during those 10 days, especially given that Registrant is a public company listed on the New York Stock Exchange.

352. Moreover, it also beggars belief to suggest that there was no written or email correspondence concerning Registrant's other Opposition proceeding against the Pioneer Supply Company regarding the use of the "PSC COLOR WORKS" mark (Opposition No. 91203773).

353. In this respect, Registrant's response of "none" is false, perjurious and designed to conceal incriminating evidence and evidence of fraud and to obstruct justice.

IV(B)19.

354. Paragraphs 344-353 of section IVB(18) are incorporated herein by reference.

355. It is alleged that by advising Registrant to so answer REQUEST TO PRODUCE NO. 8 of Applicant's First Request to Produce to Opposer under oath, Registrant's attorney, Edwin Flores, suborned perjury with the intent to deceive the USPTO into maintaining the registration of the COLORWORX mark and design element in that Mr. Flores knew that the answer was a false and misleading material misrepresentation of fact in light of his own knowledge of the oral and written statements made by Registrant and its attorneys in Opposition No. 91203884.

IV(B)20.

356. Paragraphs 344-353 of section IVB(18) are incorporated herein by reference.

357. It is alleged that by advising Registrant to so answer REQUEST TO PRODUCE NO. 8 of Applicant's First Request to Produce to Opposer under oath, Registrant's attorney, Thomas G. Jacks, suborned perjury with the intent to deceive the USPTO into maintaining the registration of the COLORWORX mark and design element in that Mr.

Jacks knew that the answer was a false and misleading material misrepresentation of fact in light of his own knowledge of the oral and written statements made by Registrant and its attorneys in Opposition No. 91203884.

IV(B)21.

358. Paragraphs 344-353 of section IVB(18) are incorporated herein by reference.

359. It is alleged that by advising Registrant to so answer REQUEST TO PRODUCE NO. 8 of Applicant's First Request to Produce to Opposer under oath, Registrant's attorney, Scott A. Myer, suborned perjury with the intent to deceive the USPTO into maintaining the registration of the COLORWORX mark and design element in that Mr. Myer knew that the answer was a false and misleading material misrepresentation of fact in light of his own knowledge of the oral and written statements made by Registrant and its attorneys in Opposition No. 91203884.

IV(B)22.

360. It is alleged that Registrant's attorneys, Chalker Flores LLP, intended to deceive both Petitioner and the USPTO into maintaining Registrant's COLORWORX registration by failing to withdraw from representing Registrant as a result of a material conflict of interest between Chalker Flores LLP and Registrant.

361. It is alleged that Chalker Flores LLP should have withdrawn from representing Registrant as a result of its own independent judgment as to the possibility of a material conflict of interest between itself and Registrant.

362. It is alleged that even if Chalker Flores LLP formed the view that there was no material conflict of interest between itself and registrant, then Chalker Flores LLP should have withdrawn from representing Registrant as a result of being made aware of such fact by Petitioner (Applicant) in his Supplement to Applicant's Initial Disclosures in Opposition No. 91203884 dated June 20, 2012, wherein he advised Chalker Flores LLP the following:

Pursuant to Rule 3.08 of the Texas Disciplinary Rules of Professional Conduct (Lawyer as Witness), I hereby give Edwin Flores, Scott A. Myer and Thomas G. Jacks of the law firm Chalker Flores LLP notice that you are bound to withdraw your representation of Ennis Inc as advocates before the Trademark Trial and Appeal Board because you are now witnesses necessary to establish an essential fact on behalf of your client, such essential fact being that Ennis Inc did not commit fraud on the USPTO by applying for and obtaining the registration of the COLORWORX mark and continue to profit from that fraud since the registration of the COLORWORX mark by using the "registered" logo on its official advertising and promotional material.

363. It is further alleged that Chalker Flores LLP should have withdrawn its representation of Registrant after receiving a correspondence from Petitioner (Applicant) in Opposition No. 91203884 which drew Chalker Flores LLP's attention to the following Texas Disciplinary Rules of Professional Conduct: "Rule 1.01, Rule 1.02, Rule 1.05, Rule 1.06, Rule 1.15, Rule 2.01, Rule 3.01, Rule 3.02, Rule 3.03, Rule 3.04, Rule 3.08, and Rule 4.01," which Rules include prescriptions as to avoiding conflicts of interest between attorneys and clients.

364. It is further alleged that Chalker Flores LLP should have withdrawn its representation of Registrant after receiving a second correspondence from Petitioner (Applicant) in Opposition No. 91203884 dated July 8, 2012 (served along with the Motion to Compel) which again drew Chalker Flores LLP's attention to the same Texas

Disciplinary Rules of Professional Conduct. “Rule 1.15, Rule 2.01, Rule 3.01, Rule 3.02, Rule 3.03, Rule 3.04, Rule 3.08, and Rule 4.01,” which Rules include prescriptions as to avoiding conflicts of interest between attorneys and clients.

365. It is alleged that Chalker Flores LLP have violated the equivalent disciplinary rules in the Trademark Rules as Rule 1.15, Rule 2.01, Rule 3.01, Rule 3.02, Rule 3.03, Rule 3.04, Rule 3.08, and Rule 4.01 of the Texas Disciplinary Rules of Professional Conduct.

366. It is alleged that Chalker Flores LLP intended to deceive both Petitioner and the USPTO into maintaining Registrant’s COLORWORX registration, in an email dated on or about the 11th July, 2012, by threatening to file a Motion for Sanctions in response to Petitioner’s (Applicant’s) good faith attempts to alert Chalker Flores LLP to its professional conduct responsibilities.

IV(B)23.

367. Petitioner refers to sections IV(B)1-23 which are incorporated herein by reference.

368. It is alleged that having obtained its registration of the COLORWORX mark and design from the USPTO, Registrant and its attorneys committed fraud on the USPTO by failing to take corrective action with respect to allegations of non-exclusivity of use of either the COLORWORX mark and/or the design element in that Petitioner advised Registrant in Opposition No. 91203884 and Cancellation No. 92055374 that it had concerns about Registrant’s rights to the exclusive use of the COLORWORX mark

and/or the design element and Registrant failed to take corrective action by voluntarily canceling its registration.

369. It is alleged that by so failing to take corrective action Registrant intended to deceive the USPTO into maintaining its registration of the COLORWORX mark and design element to which it was otherwise not entitled.

370. Since Opposer/Registrant has failed to correct a false statement and take timely corrective action during an Opposition and Petition to Cancel, it is alleged that this failure to correct creates the presumption that Opposer/Registrant had the requisite willful intent to deceive the USPTO (*University Games Corp. v. 20Q.net Inc.*, Opposition Nos. 91168142 and 91170668, 87 USPQ2d 1465 (TTAB May 2, 2008)).

PRAYER

WHEREFORE, Petitioner believes that he has been, is, and/or will be damaged by U.S. Registration No. 3,372,88 and prays that it be cancelled in the absence of a disclaimer of any portion of Registrant's mark found to be generic, descriptive and/or incapable of functioning as a trademark as applied to Ennis' services. Petitioner further seeks that any attorney referenced herein found to have breached a relevant disciplinary rule and/or committed professional misconduct be subjected to disciplinary action and/or sanctions as deemed appropriate by the Board.

Dated: July 26, 2012

Respectfully submitted,

JOEL BELING

/Joel Beling/

Joel Beling
1 Mirboo Court
Dallas, Victoria, 3047
Australia
(03) 8307 6932 (telephone)
0405 329 078 (cell)
joelbeling@hotmail.com
Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing SECOND AMENDED PETITION TO CANCEL was served on all parties, this the 26th day of July, 2012, by sending the same electronically through the Electronic System for Trademark Trials and Appeals ("ESTTA") and by email, as consented to by the Registrant's Attorneys, to the following:

Scott A. Meyer
CHALKER FLORES, LLP
smeyer@chalkerflores.com

Thomas G. Jacks
CHALKER FLORES, LLP
tjacks@chalkerflores.com
ATTORNEYS FOR REGISTRANT

Edwin Flores
CHALKER FLORES, LLP
eflores@chalkerflores.com
ATTORNEYS FOR REGISTRANT

/s/ Joel L. Beling
Joel L. Beling

Exhibit 1 (paras 121-125)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:26:01 ET

Serial Number: 75595803 Assignment Information Trademark Document Retrieval

Registration Number:(NOT AVAILABLE)

Mark(words only): COLORWORK

Standard Character claim: No

Current Status: Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was issued. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2000-06-29

Filing Date: 1998-11-25

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2000-08-29

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. CREATIVE HAIRDRESSERS, INC

Address:

CREATIVE HAIRDRESSERS, INC
2815 Hartland Road
Falls Church, VA 22043
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Virginia

GOODS AND/OR SERVICES

International Class: 042

Class Status: Active

HAIR SALON SERVICES

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2000-08-29 - Abandonment - No use statement filed

1999-12-28 - NOA Mailed - SOU Required From Applicant

1999-10-05 - Published for opposition

1999-09-03 - Notice of publication

1999-06-16 - Approved For Pub - Principal Register

1999-06-11 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Leslye S. Fenton

Correspondent

LESLYE S. FENTON

ODIN, FELDMAN & PITTLEMAN, P.C.

9302 LEE HIGHWAY, SUITE 1100

FAIRFAX, VIRGINIA 22031

Exhibit 2 (paras 126-130)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:26:48 ET

Serial Number: 78115943 Assignment Information Trademark Document Retrieval

Registration Number: 2783206

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2009-11-25

Filing Date: 2002-03-19

Transformed into a National Application: No

Registration Date: 2003-11-11

Register: Principal

Law Office Assigned: LAW OFFICE 113

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: M40 -TMO Law Office 113

Date In Location: 2009-11-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Clariant AG

Address:

Clariant AG
Rothausstrasse 61
Muttenz CH-4132
Switzerland

Legal Entity Type: Corporation

State or Country of Incorporation: Switzerland

GOODS AND/OR SERVICES

International Class: 042

Class Status: Active

Design and technical consultation services in the area of plastics coloration; technical consultation on color management in the area of plastics and development of standard color criteria for manufacturers of plastic products; technical consultation on application of color concentrates and performance enhancing chemicals in the area of plastics coloration; technical and scientific consultation and research services in the fields of chemistry and color concentrates; consultation services in the area of color matching of plastics to standards and custom color formulations

Basis: 1(a)

First Use Date: 2003-06-02

First Use in Commerce Date: 2003-06-02

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-11-25 - Section 8 (6-year) accepted & Section 15 acknowledged

2009-11-24 - Case Assigned To Post Registration Paralegal

2009-11-16 - TEAS Section 8 & 15 Received

2003-11-11 - Registered - Principal Register

2003-09-05 - Allowed for Registration - Principal Register (SOU accepted)

2003-09-03 - Assigned To Examiner

2003-08-31 - Case File In TIGRS

2003-08-01 - Statement Of Use Processing Complete

2003-06-27 - Use Amendment Filed

2003-07-07 - Extension 1 granted
2003-06-26 - Extension 1 filed
2003-06-26 - TEAS Statement of Use Received
2003-06-26 - TEAS Extension Received
2003-01-07 - NOA Mailed - SOU Required From Applicant
2002-10-15 - Published for opposition
2002-09-25 - Notice of publication
2002-08-02 - Approved For Pub - Principal Register
2002-07-25 - Assigned To Examiner
2002-04-10 - TEAS Change Of Correspondence Received
2002-04-09 - TEAS Change Of Correspondence Received

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Anthony A. Bisulca

Correspondent

Anthony A. Bisulca
CLARIANT CORPORTION
INDUSTRIAL PROPERTY DEPT.
4000 Monroe Road
Charlotte NC 28205
Phone Number: 704-331-7151
Fax Number: 704-331-7077

Domestic Representative

Anthony Bisulca
Phone Number: 704-395-6701
Fax Number: 704-395-6724

Exhibit 3 (paras 131-136)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:27:31 ET

Serial Number: 77393203 Assignment Information Trademark Document Retrieval

Registration Number: 3632494

Mark

COLORWORKS

(words only): COLORWORKS

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2009-06-02

Filing Date: 2008-02-10

Transformed into a National Application: No

Registration Date: 2009-06-02

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2009-04-29

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. New Order Organizers LLC

Address:

New Order Organizers LLC
6557 Packard Court
Mentor, OH 44060
United States

Legal Entity Type: Limited Liability Company

State or Country Where Organized: Ohio

GOODS AND/OR SERVICES

International Class: 016

Class Status: Active

Storage and organization systems comprising binders, folders, colored stickers, labels, adhesive notes and tabs for organizing, sorting, storing, and acting upon documents and the like

Basis: 1(a)

First Use Date: 2009-03-01

First Use in Commerce Date: 2009-03-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-06-02 - Registered - Principal Register

2009-04-29 - Law Office Registration Review Completed

2009-04-23 - Allowed for Registration - Principal Register (SOU accepted)

2009-04-01 - Statement Of Use Processing Complete

2009-03-11 - Use Amendment Filed

2009-04-01 - Case Assigned To Intent To Use Paralegal
2009-03-11 - TEAS Statement of Use Received
2008-09-16 - NOA Mailed - SOU Required From Applicant
2008-06-24 - Published for opposition
2008-06-04 - Notice of publication
2008-05-22 - Law Office Publication Review Completed
2008-05-22 - Assigned To LIE
2008-05-21 - Assigned To LIE
2008-05-21 - Approved For Pub - Principal Register
2008-05-21 - Examiner's Amendment Entered
2008-05-21 - Notification Of Examiners Amendment E-Mailed
2008-05-21 - Examiners amendment e-mailed
2008-05-21 - Examiners Amendment -Written
2008-05-21 - Assigned To Examiner
2008-02-14 - Notice Of Pseudo Mark Mailed
2008-02-13 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Richard S. MacMillan

Correspondent

RICHARD S. MACMILLAN
MACMILLAN, SOBANSKI & TODD, LLC
720 WATER ST., ONE MARITIME PLAZA
FIFTH FLOOR
TOLEDO, OH 43604
Phone Number: (419) 255-5900
Fax Number: (419) 255-9639

Exhibit 4 (paras 137-141)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:28:13 ET

Serial Number: 76326239 Assignment Information Trademark Document Retrieval

Registration Number: 2615133

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2008-09-02

Filing Date: 2001-10-17

Transformed into a National Application: No

Registration Date: 2002-09-03

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-09-02

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Horizon International Inc.

Address:

Horizon International Inc.
1601 Aza Shironoshita, Oaza Asahi Shinasahimachi, Takashimagun
Shiga
Japan

Legal Entity Type: Corporation

State or Country of Incorporation: Japan

GOODS AND/OR SERVICES

International Class: 007

Class Status: Active

Apparatus, machines, and machine tools, all for handling and working paper, boards and books, namely, machines for folding, binding, collating, cutting, stitching, spine taping, jogging and drafting paper, boards and books; and replacement parts for the aforementioned apparatus, machines, and machine tools

Basis: 1(a)

First Use Date: 2001-09-06

First Use in Commerce Date: 2001-09-06

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-09-02 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-08-21 - Assigned To Paralegal

2008-08-14 - TEAS Section 8 & 15 Received

2007-11-30 - Case File In TIGRS

2005-06-16 - TEAS Change Of Correspondence Received

2003-12-28 - TEAS Change Of Correspondence Received

2002-09-03 - Registered - Principal Register

2002-06-11 - Published for opposition

2002-05-22 - Notice of publication

2002-03-06 - Approved for Pub - Principal Register (Initial exam)

2002-01-11 - Communication received from applicant

2002-01-07 - Non-final action mailed

2001-12-28 - Assigned To Examiner

2001-12-27 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Kumiko Ide

Correspondent

Kumiko Ide

Westerman, Hattori, Daniels & Adrian LLP

Suite 700

1250 Connecticut Avenue, NW

Washington DC 20036

Phone Number: 202-822-1100

Fax Number: 202-822-1111

Domestic Representative

Kumiko Ide

Phone Number: 202-822-1100

Fax Number: 202-822-1111

Exhibit 5 (paras 142-146)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:29:53 ET

Serial Number: 76204750 Assignment Information Trademark Document Retrieval

Registration Number: 2524890

Mark(words only): GALLERY COLORWORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2008-10-04

Filing Date: 2001-02-05

Transformed into a National Application: No

Registration Date: 2002-01-01

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-04-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

I. TACONY CORPORATION

Address:

TACONY CORPORATION
1760 Gilsinn Lane
Fenton, MO 63026
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Missouri

GOODS AND/OR SERVICES

International Class: 009

Class Status: Section 8 - Cancelled

Computer software for use by home machine embroiderers to simulate the sewing of embroidery designs and/or to modify the sequencing of color sections in embroidery designs

Basis: 1(a)

First Use Date: 2001-02-27

First Use in Commerce Date: 2001-02-27

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-10-04 - Canceled Section 8 (6-year)

2007-04-23 - Case File In TIGRS

2002-01-01 - Registered - Principal Register

2001-10-09 - Published for opposition

2001-09-19 - Notice of publication

2001-06-12 - Amendment to Use approved

2001-06-12 - Approved For Pub - Principal Register

2001-06-04 - Examiner's amendment mailed

2001-05-31 - Assigned To Examiner

2001-05-24 - Assigned To Examiner

2001-05-23 - Amendment To Use Processing Complete

2001-03-06 - Use Amendment Filed

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Amy Rehm Hinderer

Correspondent

AMY REHM HINDERER
TACONY CORPORATION
1760 GILSINN LN
FENTON MO 63026-2004

Exhibit 6 (paras 147-151)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:32:46 ET

Serial Number: 85227723 Assignment Information Trademark Document Retrieval

Registration Number:(NOT AVAILABLE)

Mark

COLORWORKS

(words only): COLORWORKS

Standard Character claim: Yes

Current Status: Approved by the examining attorney for publication but has not yet published for opposition. Although rare, withdrawal of approval prior to publication may occur after final review. The opposition period begins on the date of publication.

Date of Status: 2012-07-24

Filing Date: 2011-01-27

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 116

Attorney Assigned:
AWRICH ELLEN

Current Location: M7X -TMO Law Office 116 - Examining Attorney Assigned

Date In Location: 2012-07-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. DUNCAN ENTERPRISES

DBA/AKA/TA/Formerly: DBA iLoveToCreate

Address:

DUNCAN ENTERPRISES

5673 E. Shields Ave.

Fresno, CA 93727

United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

Phone Number: 559-294-3391

Fax Number: 559-294-2447

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

Downloadable lessons and instruction videos featuring educational ceramic art projects, for educators and students in kindergarten through grade 12

Basis: 1(a)

First Use Date: 2000-05-31

First Use in Commerce Date: 2000-05-31

International Class: 041

Class Status: Active

Providing a website featuring on-line publications, namely, on-line non-downloadable lessons featuring educational ceramic art projects, for educators and students in kindergarten through grade 12; Providing a website featuring on-line non-downloadable instructional videos in the field of educational ceramic art projects for educators and students in kindergarten through grade 12

Basis: 1(a)

First Use Date: 2000-05-31

First Use in Commerce Date: 2000-05-31

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2012-07-24 - Approved for Pub - Principal Register (Initial exam)
2012-07-23 - Teas/Email Correspondence Entered
2012-07-21 - Communication received from applicant
2012-07-21 - TEAS Request For Reconsideration Received
2012-07-21 - TEAS Change Of Correspondence Received
2012-04-17 - Notification Of Final Refusal Emailed
2012-04-17 - Final refusal e-mailed
2012-04-17 - Final Refusal Written
2011-10-17 - Notification Of Letter Of Suspension E-Mailed
2011-10-17 - LETTER OF SUSPENSION E-MAILED
2011-10-17 - Suspension Letter Written
2011-10-14 - TEAS Change Of Correspondence Received
2011-10-14 - Teas/Email Correspondence Entered
2011-10-14 - Communication received from applicant
2011-10-14 - TEAS Response to Office Action Received
2011-04-15 - Notification Of Non-Final Action E-Mailed
2011-04-15 - Non-final action e-mailed
2011-04-15 - Non-Final Action Written
2011-04-12 - Assigned To Examiner
2011-02-02 - Notice Of Pseudo Mark Mailed
2011-02-01 - New Application Office Supplied Data Entered In Tram
2011-01-31 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

DUNCAN ENTERPRISES

DUNCAN ENTERPRISES

5673 E. SHIELDS AVE

FRESNO CA 93727

Phone Number: 559-294-3374

Fax Number: 559-294-2447

Exhibit 7 (paras 152-156)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:33:28 ET

Serial Number: 75643179 Assignment Information Trademark Document Retrieval

Registration Number: 2453770

Mark(words only): COLOR WORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2011-12-23

Filing Date: 1999-02-17

Transformed into a National Application: No

Registration Date: 2001-05-22

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2007-06-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SWIMC, INC.

Address:

SWIMC, INC.
PO Box 657
Newark, DE 197150657
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 020

Class Status: Section 8 - Cancelled

display racks used to display paint color cards

Basis: 1(a)

First Use Date: 2000-12-12

First Use in Commerce Date: 2000-12-12

ADDITIONAL INFORMATION

Disclaimer: "COLOR"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-12-23 - Canceled Section 8 (10-year)/Expired Section 9

2009-11-12 - Applicant/Correspondence Changes (Non-Responsive) Entered

2009-11-12 - TEAS Change Of Owner Address Received

2007-06-28 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-06-15 - Assigned To Paralegal

2007-05-22 - Section 8 (6-year) and Section 15 Filed

2007-05-22 - TEAS Section 8 & 15 Received

2006-10-31 - Case File In TIGRS

2001-05-22 - Registered - Principal Register

2001-03-01 - Allowed for Registration - Principal Register (SOU accepted)

2001-02-22 - Statement Of Use Processing Complete

2000-12-20 - Use Amendment Filed

2000-06-20 - NOA Mailed - SOU Required From Applicant

2000-03-28 - Published for opposition

2000-02-25 - Notice of publication

2000-01-13 - Approved For Pub - Principal Register

1999-12-13 - Communication received from applicant

1999-06-14 - Non-final action mailed

1999-06-11 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Robert E. McDonald

Correspondent

ROBERT E MCDONALD, REG. NO. 29,193
101 PROSPECT AVENUE NW
1100 MIDLAND BLDG. - LEGAL DEPT.
CLEVELAND OH 44115-1075
Phone Number: 2165662432
Fax Number: 2165154400

Exhibit 8 (paras 157-161)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:34:07 ET

Serial Number: 75643180 Assignment Information Trademark Document Retrieval

Registration Number: 2476288

Mark(words only): COLOR WORKS

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2011-03-02

Filing Date: 1999-02-17

Transformed into a National Application: No

Registration Date: 2001-08-07

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: (NOT AVAILABLE)

Date In Location: 2011-03-02

LAST APPLICANT(S)/OWNER(S) OF RECORD

I. SWIMC, INC.

Address:

SWIMC, INC.

PO Box 657

Newark, DE 197150657

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 016

Class Status: Active

paint color cards

Basis: 1(a)

First Use Date: 2000-12-12

First Use in Commerce Date: 2000-12-12

ADDITIONAL INFORMATION

Disclaimer: "COLOR"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-03-02 - First renewal 10 year

2011-03-02 - Section 8 (10-year) accepted/ Section 9 granted

2011-02-11 - TEAS Section 8 & 9 Received

2009-11-12 - Applicant/Correspondence Changes (Non-Responsive) Entered

2009-11-12 - TEAS Change Of Owner Address Received

2007-08-23 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-08-21 - Assigned To Paralegal

2007-07-30 - Section 8 (6-year) and Section 15 Filed

2007-07-30 - TEAS Section 8 & 15 Received

2007-02-20 - Case File In TIGRS

2001-08-07 - Registered - Principal Register

2001-05-01 - Allowed for Registration - Principal Register (SOU accepted)

2001-04-23 - Statement Of Use Processing Complete

2000-12-20 - Use Amendment Filed
2000-06-20 - NOA Mailed - SOU Required From Applicant
2000-03-28 - Published for opposition
2000-02-25 - Notice of publication
2000-01-13 - Approved For Pub - Principal Register
1999-12-13 - Communication received from applicant
1999-06-14 - Non-final action mailed
1999-06-09 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Robert E. McDonald, REG. NO. 29,193

Correspondent

Robert E. McDonald, REG. NO. 29,193
c/o The Sherwin-Williams Company
1100 Midland Bldg. - Legal Dept.
101 W. Prospect Avenue
CLEVELAND OH 44115-1075
Phone Number: 2165662432
Fax Number: 2165154400

Exhibit 9 (paras 162-166)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:34:53 ET

Serial Number: 75617896 Assignment Information Trademark Document Retrieval

Registration Number:(NOT AVAILABLE)

Mark(words only): COLOR WORKS

Standard Character claim: No

Current Status: Abandoned because the applicant failed to respond or filed a late response to an Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2000-01-28

Filing Date: 1999-01-12

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2000-02-07

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Vallier, Deandra K.

Address:

Vallier, Deandra K.
1101 Sherman Avenue
Hood River, OR 97031
United States

Legal Entity Type: Individual
Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 003
Class Status: Active
Cosmetic Eye Drops
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2000-01-28 - Abandonment - Failure To Respond Or Late Response

1999-05-20 - Non-final action mailed

1999-05-13 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent
DEANDRA K. VALLIER
1101 SHERMAN AVENUE
HOOD RIVER OREGON 97031

Exhibit 10 (paras 167-171)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:35:32 ET

Serial Number: 75562272 Assignment Information Trademark Document Retrieval

Registration Number: 2451486

Mark(words only): COLOR WORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2008-02-23

Filing Date: 1998-09-30

Transformed into a National Application: No

Registration Date: 2001-05-15

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2006-11-03

LAST APPLICANT(S)/OWNER(S) OF RECORD

I. Mars, Incorporated

Address:

Mars, Incorporated
6885 Elm Street
McLean, VA 221013883
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009
Class Status: Section 8 - Cancelled
Candy vending machines
Basis: 1(a)
First Use Date: 1996-08-00
First Use in Commerce Date: 1996-08-00

ADDITIONAL INFORMATION

Prior Registration Number(s):
2103537
2115953

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-23 - Canceled Section 8 (6-year)
2007-01-10 - Attorney Revoked And/Or Appointed
2007-01-10 - TEAS Revoke/Appoint Attorney Received
2006-11-03 - Case File In TIGRS
2001-05-15 - Registered - Principal Register
2001-01-19 - Allowed for Registration - Principal Register (SOU accepted)
2001-01-19 - Assigned To Examiner
2000-10-05 - Statement Of Use Processing Complete
2000-10-05 - Use Amendment Filed
2000-05-04 - Extension 1 granted

2000-03-13 - Extension 1 filed

1999-10-26 - NOA Mailed - SOU Required From Applicant

1999-08-03 - Published for opposition

1999-07-02 - Notice of publication

1999-04-26 - Approved For Pub - Principal Register

1999-04-14 - Assigned To Examiner

1999-04-09 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Leslie K. Mitchell, Esq.

Correspondent

Leslie K. Mitchell, Esq.

Arent Fox LLP

1675 Broadway

New York NY 10019

Phone Number: (212) 484-3900

Fax Number: (212) 484-3990

Exhibit 11 (paras 172-176)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:36:07 ET

Serial Number: 75536245 Assignment Information Trademark Document Retrieval

Registration Number: 2313535

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2010-02-02

Filing Date: 1998-08-13

Transformed into a National Application: No

Registration Date: 2000-02-01

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: (NOT AVAILABLE)

Date In Location: 2010-02-02

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. TARKETT INC.

Address:

TARKETT INC.
1001, RUE YAMASKA
FARNHAM, QC J2N 1J7
Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 027

Class Status: Active

SHEET VINYL AND VINYL TILE FLOORING

Basis: 1(a)

First Use Date: 1995-02-00

First Use in Commerce Date: 1995-02-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-02-02 - First renewal 10 year

2010-02-02 - Section 8 (10-year) accepted/ Section 9 granted

2010-02-01 - Case Assigned To Post Registration Paralegal

2010-01-27 - TEAS Section 8 & 9 Received

2006-05-15 - Case File In TIGRS

2006-02-02 - Section 8 (6-year) accepted & Section 15 acknowledged

2005-11-29 - Section 8 (6-year) and Section 15 Filed

2005-11-29 - TEAS Section 8 & 15 Received

2005-07-12 - Attorney Revoked And/Or Appointed

2005-07-12 - TEAS Revoke/Appoint Attorney Received

2000-02-01 - Registered - Principal Register

1999-11-09 - Published for opposition

1999-10-08 - Notice of publication

1999-07-30 - Notice of publication

1999-04-27 - Approved for Pub - Principal Register (Initial exam)

1999-04-14 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

SIMON LEMAY

Correspondent

SIMON LEMAY

LAVERY DE BILLY

Suite 500

925 Grande Allee West

QUÉBEC CITY G1S1C1 Canada

Phone Number: 418-266-3064

Fax Number: 418-688-3458

Exhibit 12 (paras 177-182)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:36:52 ET

Serial Number: 75193153 Assignment Information Trademark Document Retrieval

Registration Number: 2103537

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2008-07-07

Filing Date: 1996-10-31

Transformed into a National Application: No

Registration Date: 1997-10-07

Register: Principal

Law Office Assigned: LAW OFFICE 101

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-07-07

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Mars, Incorporated

Address:

Mars, Incorporated
6885 Elm Street
McLean, VA 221013883
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 030
Class Status: Section 8 - Cancelled
candy
Basis: 1(a)
First Use Date: 1996-10-04
First Use in Commerce Date: 1996-10-04

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-07-07 - Canceled Section 8 (10 year)
2007-03-01 - Case File In TIGRS
2007-01-10 - Attorney Revoked And/Or Appointed
2007-01-10 - TEAS Revoke/Appoint Attorney Received
2003-12-03 - Section 8 (6-year) accepted & Section 15 acknowledged
2003-10-10 - Section 8 (6-year) and Section 15 Filed
1997-10-07 - Registered - Principal Register
1997-07-15 - Published for opposition
1997-06-13 - Notice of publication
1997-05-08 - Approved for Pub - Principal Register (Initial exam)
1997-05-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Leslie K. Mitchell, Esq.

Correspondent

Leslie K. Mitchell, Esq.

Arent Fox LLP

1675 Broadway

New York NY 10019

Phone Number: (212) 484-3900

Fax Number: (212) 484-3990

Exhibit 13 (paras 183-187)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:37:26 ET

Serial Number: 75193152 Assignment Information Trademark Document Retrieval

Registration Number: 2115953

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2008-07-07

Filing Date: 1996-10-31

Transformed into a National Application: No

Registration Date: 1997-11-25

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-07-07

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Mars, Incorporated

Address:

Mars, Incorporated
6885 Elm Street
McLean, VA 221013883
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 020

Class Status: Section 8 - Cancelled

display cases for displaying candy products which allow the purchaser to create its own combination of different color candies

Basis: 1(a)

First Use Date: 1996-10-04

First Use in Commerce Date: 1996-10-04

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-07-07 - Canceled Section 8 (10 year)

2007-02-13 - Case File In TIGRS

2007-01-10 - Attorney Revoked And/Or Appointed

2007-01-10 - TEAS Revoke/Appoint Attorney Received

2004-02-19 - Section 8 (6-year) accepted & Section 15 acknowledged

2003-11-28 - Section 8 (6-year) and Section 15 Filed

1997-11-25 - Registered - Principal Register

1997-09-02 - Published for opposition

1997-08-01 - Notice of publication

1997-07-07 - Approved for Pub - Principal Register (Initial exam)

1997-06-30 - Examiner's amendment mailed

1997-06-13 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Leslie K. Mitchell, Esq.

Correspondent

Leslie K. Mitchell, Esq.

Arent Fox LLP

1675 Broadway

New York NY 10019

Phone Number: (212) 484-3900

Fax Number: (212) 484-3990

Exhibit 14 (paras 188-192)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:38:03 ET

Serial Number: 75463213 Assignment Information Trademark Document Retrieval

Registration Number:(NOT AVAILABLE)

Mark(words only): COLOR WORKS

Standard Character claim: No

Current Status: Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was issued. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2000-12-23

Filing Date: 1998-04-06

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2001-05-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Vallier, Deandra K.

Address:

Vallier, Deandra K.
1101 Sherman Avenue
Hood River, OR 97031
United States

Legal Entity Type: Individual
Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 005

Class Status: Active

OPHTHALMIC PREPARATIONS

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2001-05-19 - Abandonment - No use statement filed

2000-08-15 - Extension 2 granted

2000-06-19 - Extension 2 filed

2000-01-24 - Extension 1 granted

1999-12-06 - Extension 1 filed

1999-06-22 - NOA Mailed - SOU Required From Applicant

1999-03-30 - Published for opposition

1999-02-26 - Notice of publication

1998-12-22 - Approved For Pub - Principal Register

1998-12-02 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

DEANDRA K VALLIER
1101 SHERMAN AVE
HOOD RIVER OR 97031

Exhibit 15 (paras 193-197)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:38:47 ET

Serial Number: 75224752 Assignment Information Trademark Document Retrieval

Registration Number:(NOT AVAILABLE)

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: Abandoned because the applicant failed to respond or filed a late response to an Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 1998-07-02

Filing Date: 1997-01-13

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 1998-10-07

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Owens-Corning Fiberglas Technology Inc.

Address:

Owens-Corning Fiberglas Technology Inc.
7734 West 59th Street
Summit, IL 605010907
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Illinois

GOODS AND/OR SERVICES

International Class: 009

Class Status: Abandoned

computer programs for use in selecting color schemes for the exterior of a house

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 019

Class Status: Abandoned

roofing shingles, vinyl siding and non-metal windows and doors

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

1998-07-02 - Abandonment - Failure To Respond Or Late Response

1997-10-07 - Non-final action mailed

1997-07-30 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

C MICHAEL GEGENHEIMER

Correspondent

C MICHAEL GEGENHEIMER

LAW DEPT/ATTN TRADEMARK ADMINISTRATOR
I OWENS CORNING PKWY
TOLEDO OH 43659

Exhibit 16 (paras 198-202)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:39:37 ET

Serial Number: 75204999 Assignment Information Trademark Document Retrieval

Registration Number: 2210089

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2009-07-18

Filing Date: 1996-11-27

Transformed into a National Application: No

Registration Date: 1998-12-15

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-08-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. COLORWORKS COLLEGIATE PAINTERS, Inc., THE

Address:

COLORWORKS COLLEGIATE PAINTERS, Inc., THE
P.O. Box 677
Richland, MI 49083
United States

Legal Entity Type: Corporation
State or Country of Incorporation: Michigan

GOODS AND/OR SERVICES

International Class: 037

Class Status: Section 8 - Cancelled

painting services, namely, residential and commercial building painting services and related repair, cleaning, and painting preparation services, all of which are primarily performed by college students

Basis: 1(a)

First Use Date: 1991-10-01

First Use in Commerce Date: 1991-10-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-07-18 - Canceled Section 8 (10-year)/Expired Section 9

2007-08-01 - Case File In TICS

2004-11-22 - Section 8 (6-year) accepted & Section 15 acknowledged

2004-10-08 - Section 8 (6-year) and Section 15 Filed

2004-10-08 - PAPER RECEIVED

1998-12-15 - Registered - Principal Register

1998-09-22 - Published for opposition

1998-08-21 - Notice of publication

1998-07-14 - Approved for Pub - Principal Register (Initial exam)

1998-02-02 - Assigned To Examiner

1997-09-02 - Communication received from applicant

1997-07-09 - Communication received from applicant

1997-06-24 - Non-final action mailed

1997-06-18 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

RICHARD A. GAFFIN

Correspondent

RICHARD A. GAFFIN
MILLER, CANFIELD, PADDOCK & STONE, PLC
1200 CAMPAU SQUARE PLAZA
99 MONROE AVE., NW
GRAND RAPIDS, MI 49503

Exhibit 17 (paras 203-207)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:40:10 ET

Serial Number: 75072159 Assignment Information Trademark Document Retrieval

Registration Number: 2349187

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2010-12-17

Filing Date: 1996-03-13

Transformed into a National Application: No

Registration Date: 2000-05-16

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-05-03

LAST APPLICANT(S)/OWNER(S) OF RECORD

I. FLM GRAPHICS CORPORATION

Address:

FLM GRAPHICS CORPORATION
123 Lehigh Drive
Fairfield, NJ 07004
United States

Legal Entity Type: Corporation
State or Country of Incorporation: New Jersey

GOODS AND/OR SERVICES

International Class: 016
Class Status: Section 8 - Cancelled
computer generated color prints
Basis: 1(a)
First Use Date: 1993-07-01
First Use in Commerce Date: 1993-07-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-12-17 - Canceled Section 8 (10-year)/Expired Section 9

2006-05-03 - Section 8 (6-year) accepted

2006-05-03 - Assigned To Paralegal

2006-04-10 - Case File In TIGRS

2006-02-06 - Section 8 (6-year) filed

2006-02-06 - PAPER RECEIVED

2000-05-16 - Registered - Principal Register

2000-02-26 - Opposition terminated for Proceeding

1999-09-01 - Opposition dismissed for Proceeding

1997-02-12 - Opposition instituted for Proceeding

1996-12-18 - Extension Of Time To Oppose Received

1996-11-26 - Published for opposition

1996-10-25 - Notice of publication

1996-09-13 - Approved for Pub - Principal Register (Initial exam)

1996-09-09 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

FLM GRAPHICS CORPORATION
123 LEHIGH DRIVE
FAIRFIELD, NJ 07004

Exhibit 18 (paras 208-212)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-07-26 23:40:41 ET

Serial Number: 74579788 Assignment Information Trademark Document Retrieval

Registration Number: 2000638

Mark(words only): COLORWORKS

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2006-11-21

Filing Date: 1994-09-29

Transformed into a National Application: No

Registration Date: 1996-09-17

Register: Principal

Law Office Assigned: LAW OFFICE 108

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-11-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SEARS, ROEBUCK AND CO.

Address:

SEARS, ROEBUCK AND CO.
3333 BEVERLY ROAD DEPT. 766X, B6-363B
HOFFMAN ESTATES, IL 60179
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 003

Class Status: Active

cosmetics, namely lipstick, eyeshadow, blush, foundation, eyeliner, mascara, lip liner

Basis: 1(a)

First Use Date: 1995-10-15

First Use in Commerce Date: 1995-10-15

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2012-05-31 - Attorney Revoked And/Or Appointed

2012-05-31 - TEAS Revoke/Appoint Attorney Received

2009-08-05 - Attorney Revoked And/Or Appointed

2009-08-05 - TEAS Revoke/Appoint Attorney Received

2009-04-08 - TEAS Change Of Correspondence Received

2007-08-03 - Attorney Revoked And/Or Appointed

2007-08-03 - TEAS Revoke/Appoint Attorney Received

2006-11-21 - First renewal 10 year

2006-11-21 - Section 8 (10-year) accepted/ Section 9 granted

2006-11-08 - Assigned To Paralegal

2006-09-12 - Combined Section 8 (10-year)/Section 9 filed

2006-09-12 - TEAS Section 8 & 9 Received

2006-07-05 - Case File In TICS
2005-06-03 - Attorney Revoked And/Or Appointed
2005-06-03 - TEAS Revoke/Appoint Attorney Received
2005-06-03 - Attorney Revoked And/Or Appointed
2005-06-03 - TEAS Revoke/Appoint Attorney Received
2002-12-13 - Section 8 (6-year) accepted & Section 15 acknowledged
2002-10-21 - Post Registration action correction
2002-09-16 - Section 8 (6-year) and Section 15 Filed
2002-09-16 - PAPER RECEIVED
1996-09-17 - Registered - Principal Register
1996-06-25 - Published for opposition
1996-05-24 - Notice of publication
1996-03-30 - Approved for Pub - Principal Register (Initial exam)
1996-03-30 - Amendment to Use approved
1995-12-11 - Communication received from applicant
1996-02-25 - Amendment To Use Processing Complete
1995-12-11 - Use Amendment Filed
1995-12-11 - Communication received from applicant
1995-06-14 - Non-final action mailed
1995-03-03 - Assigned To Examiner
1995-02-24 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Ronald A. DiCerbo

Correspondent

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Chicago IL 60661
Phone Number: 312-775-8000
Fax Number: 312-775-8100

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **EXHIBITS TO PETITIONER'S SECOND AMENDED PETITION TO CANCEL** was served on all parties, this the 27TH day of July 2012, by sending the same electronic mail, to the following:

Scott A. Meyer
Thomas Jacks
CHALKER FLORES, LLP
smeyer@chalkerflores.com
tjacks@chalkerflores.com
ATTORNEYS FOR OPPOSER

/Joel Beling/
Joel Beling
Applicant

CERTIFICATE OF MAILING

Opposition No.: 91203884
Cancellation No.: 92055374

I hereby certify that this Petitioner's Second Amended Petition to Cancel and Exhibits is being deposited with Australia Post in an envelope addressed to: Commissioner for Trademarks, PO Box 1451, Alexandria, Virginia 22313-1451 on the date shown below.

JOEL BELING

A handwritten signature in black ink, appearing to read "JOEL BELING", is written over a horizontal line.

27 July 2012